

How the Other Half Lives (Revisited):  
Twenty Years Since Midler v. Ford  
A Global Perspective on the Right of Publicity

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## Introduction

For celebrities, name and image are, arguably, two of their most valuable assets. From headlining a movie, to starring in a commercial, to endorsing a product, a celebrity's persona is potentially worth thousands to millions of dollars. However, this intangible commodity's worth is often siphoned off by those who appropriate a celebrity's name or image without authorization or remuneration, thus potentially decreasing the property's value. In order to stifle this unjust enrichment, celebrities greatly desire the absolute right to control the commercial exploitation of their name and likeness.

Commonly known as the right of publicity, more than half the states in the U.S.<sup>1</sup> now recognize, in one form or another, at least a limited right to control the commercial exploitation of a "person's indicia of identity".<sup>2</sup> A relatively recent doctrine, extending traditional notions of property rights, the right of publicity was first coined 50 years ago by Judge Jerome Frank in the seminal case of Haelen Laboratories v. Topps Chewing Gum, defining the right as "the right of a man in the publicity value of his likeness".<sup>3</sup> Since Haelen, the right of publicity body of law has evolved, wholly on the state level, through both common law and statutory enactments. For many states, this protection is limited to a person's name or picture. Yet for others, led, not surprisingly, by the Ninth Circuit, the definitional parameters of protection are broader and more inclusive of traits related directly to a celebrity's persona.

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<sup>1</sup> F. Jay Dougherty, International Right of Publicity Symposium: Forward: The Right of Publicity – Towards a Comparative and International Perspective, 18 LOYOLA L.A. ENT. L.J. 421, 424 (1998).

<sup>2</sup> *Id.* at 423.

<sup>3</sup> Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2nd Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

Extending protection to a celebrity's traits came to the forefront of jurisprudence 20 years ago in the case between legendary crooner Bette Midler and the Ford Motor Company.<sup>4</sup> Further discussed below, Ford initially offered Midler the opportunity to perform one of her songs for an upcoming commercial. Midler declined the invitation, in line with her career-long stance against endorsing products.<sup>5</sup> Thereafter, instead of obtaining a compulsory license and hiring another singer to record the song for the ad, Midler alleged that Ford deliberately engaged one of her former back-up singers to imitate Midler's voice.<sup>6</sup> Consequently, those viewing the commercial had the impression that Midler was actually the one performing. Differentiating between Midler and the real performer was further tenuous since the song was initially recorded by Midler and had achieved considerable fame.<sup>7</sup>

As a result, Midler sued Ford for violation of her right of publicity under both the California statutory code and common law. Midler argued that Ford had misappropriated her likeness and persona by imitating her highly recognizable voice in the commercial. Although the court dismissed her statutory claim based on a strict reading of the code's language, they held that she could maintain a claim under the broader common law protection that included misappropriation of a celebrity's "indicia of identity" beyond those stipulated in the state statute.<sup>8</sup> Midler became a landmark decision in expanding the "unique" characteristics over which celebrities retain almost unilateral control.

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<sup>4</sup> See Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988). The original commercials were produced in 1985.

<sup>5</sup> *Id.* at 461.

<sup>6</sup> *Id.* at 462.

<sup>7</sup> *Id.*

<sup>8</sup> See generally *Id.*

Since Midler, the Ninth Circuit, as well as most jurisdictions recognizing the right of publicity, continues to struggle in establishing definitive boundaries for protecting a celebrity's "likeness" and persona. While some courts have created an expanded definition of protectable characteristics, to incorporate those innately related to the celebrity and thus capable of commercial misappropriation, others have retained a narrower interpretation, protecting only the unauthorized use of a celebrity's name and image.<sup>9</sup> The struggle for a clear and precise definition, in part because of ambiguous statutory language and intent, is made all the more complicated due to the lack of a federal right of publicity statute. This lack of harmonization has led many right of publicity experts, as well as the American Bar Association to recommend the enactment of a federal protection scheme.<sup>10</sup> Most experts argue that a federal statute is necessary in order to curb significant forum shopping and to provide advertisers and celebrities with the precise boundaries of protection.<sup>11</sup>

Unlike acts wholly contained within a state's borders, technological innovations and the pervasiveness of advertising have no such restrictions. The same situation exists with most products bearing a celebrity's endorsement. The continued advancements and reach of the Internet, due, in particular, to broadband technology, serves to further highlight the borderless world in which parties conduct business. Consequently, this premise underlies the strong call for a national right of publicity. This article contends that a celebrity's publicity right should not differ between two states in which their likeness is misappropriated as a result of the same tortious act. Ford's nationwide

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<sup>9</sup> See generally, Kevin M. Fisher, Comment, Which Path to Follow: A Comparative Perspective on the Right of Publicity, 16 CONN. J. INT'L L. 95 (2000).

<sup>10</sup> Marci A. Hamilton, et al., Right of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress, 16 CARDOZO ARTS & ENT. L.J. 209, 210, 214 (1998).

<sup>11</sup> See *Id.*

commercial does not only injure Midler in California, the state of residence, but, potentially, in all states where her image carries intrinsic value. Therefore, Midler should have a viable remedy in all jurisdictions where she is harmed.

Although this paper contends that a federal right of publicity is appropriate and necessary, it posits that right of publicity protection must now embrace the global marketplace through a well-defined international scheme by which persons, celebrities and non-celebrities alike may prevent the unauthorized and uncompensated commercialization of their name and likeness. The Internet and satellite television have led to the internationalization of advertisements. Furthermore, the intrinsic value of the global “merchandising” of celebrities has by no shortage of the imagination grown significantly in the last decade.<sup>12</sup> Consequently, akin to the justifications for global intellectual property protection, the right of publicity, almost universally recognized as a neighboring right to either copyright or trademark, deserves protection within a uniform, global framework.

To that end, this paper draws comparisons between the “right of publicity” protection devices, or synonymous laws, of the United States and several major foreign marketplaces. It will also examine the potential existence of such rights under several international intellectual property agreements and conventions, while analyzing the enforcement mechanisms to potential plaintiffs.

Part I examines the historical perspectives and justifications for the right of publicity within the United States, including an examination of the seminal cases leading to the Midler decision. Part II will discuss the right of publicity laws in the two leading jurisdictions – California and New York – and how lawmakers and judges in these

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<sup>12</sup> Dougherty, *supra* note 1, at 421.

circuits have handed-down vastly divergent right of publicity decisions, leading to conflicting protection and, therefore, a lack of national harmonization. Part III will analyze the right of publicity protection, if any, within the laws of several countries throughout the world, including the United Kingdom, France, Brazil, and Argentina. Finally, Part IV will discuss the potential existence of a right of publicity or, if none exists, the need for such protection under current international intellectual property treaties. Part V will examine under which regime of intellectual property law, copyright or trademark, does right of publicity protection naturally exist, if either. Lastly, Part VI will put forth a proposed statutory and remedial international protection scheme.

## **Part I: The Right of Publicity**

### **A. Right of Publicity Historical Roots**

The right of publicity is often described as the “inherent right of every human being to control the commercial use of his or her identity”.<sup>13</sup> Though related to property rights, the doctrine’s origins shed light on protection encompassing both monetary and emotional injuries. In order to understand the contemporary state of the right of publicity doctrine, both in the United States and globally, this part discusses the origins and rationales for the protection.

#### **i. Invasion of Privacy Origins**

Most scholars posit that the right of publicity doctrine emerged from the tort for invasion of privacy. Sixty years before Haelan, Samuel Warren and Louis Brandeis authored an oft-cited Harvard Law Review article proposing the idea of a private cause of

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<sup>13</sup> Henley v. Dillard Department Stores, 46 F. Supp. 2d 587, 590 (N.D. Tex. 1999) (*quoting*, J. Thomas McCarthy, Melville B. Nimmer Symposium: Article: Melville B. Nimmer and the Right of Publicity: A Tribute, 34 UCLA L. REV. 1703, at 1704 (1987)).



action for invasion of privacy.<sup>14</sup> Warren and Brandeis argued that the law needed to protect private persons from the harm and embarrassment of the public disclosure of private facts by the media, regardless of truth.<sup>15</sup>

Fifteen years after Warren and Brandeis first introduced the idea for an invasion of privacy tort, the Georgia Supreme Court, in Pasevich v. New England Life Insurance Co., explicitly recognized the validity of such a claim.<sup>16</sup> In addition to the recognition of a common law right, under Pasevich,<sup>17</sup> several states followed suit and enacted right of privacy statutes focusing on the personal dignity of an individual for emotional injuries stemming from an invasion of their privacy.<sup>18</sup>

Decades of precedent and statutory enactments led to a significant body of law interpreting the invasion of privacy as protecting against the emotional harms resulting from the unauthorized use of one's identity.<sup>19</sup> However, the "privacy" requirement in Warren and Brandeis' article, as well as statutory enactments for invasion of privacy posed significant problem for celebrities' ability to redress claims for the unauthorized and unremunerated use of their name or likeness for commercial purposes.

First, some jurisdictions refused to recognize a common law right of privacy, either in its entirety or broad enough to encompass a celebrity's commercial misappropriation claim.<sup>20</sup> As discussed in Part II, the highest court in New York,<sup>21</sup> as

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<sup>14</sup> See, Samuel Warren & Louis Brandeis, The Right of Privacy, 4 HARV. L. REV. 193 (1890)

<sup>15</sup> Joshua Waller, Comment, The Right of Publicity: Preventing the Exploitation of a Celebrity's Identity or Promoting the Exploitation of the First Amendment?, 9 UCLA ENT. L. REV. 59, 60 (2001) (*citing* Warren & Brandeis, The Right of Privacy, 4 HARV. L. REV. 193 (1890)).

<sup>16</sup> Pasevich v. New England Life Insurance Co., 122 Ga. 190 (1905)

<sup>17</sup> *See Id.*

<sup>18</sup> Waller, *supra* note 15, at 60.

<sup>19</sup> *Id.*; Ashley D. Hayes, Note, The Right of Publicity and Protection of Persona: Preemption Not Required, 51 SYR. L. REV. 1049, 1057 (2001).

<sup>20</sup> See, Paul Cirino, Advertisers, Celebrities, and Publicity Rights in New York and California, 39 N.Y.L. SCHOOL L. REV. 763, 771-778 (1994).

early as 1901, explicitly stated that a common law right of privacy did not exist. The state's legislature quickly enacted a statutory remedy making it a misdemeanor to use the name or portrait of any person for advertising purposes without their authorization.<sup>22</sup> Though an appropriate corrective measure to the court's decision, subsequent New York decisions have not only narrowly defined the parameters of protection under the statute, but courts have used the statute's enactment as further proof that a common law right of publicity, under the rubric of a privacy law, does not exist.<sup>23</sup> As this article will discuss, the California court's recognition of a common law publicity right, protecting attributes beyond those explicitly enumerated in the statutory code, proved vital in providing Midler, and similarly-situated plaintiffs, a proper and redressable claim.

The other major historical hurdle for a celebrity's invocation of a state's invasion of privacy law was that most courts interpreted the statute narrowly, thus requiring plaintiff's to prove that they were indeed private individuals. Courts reasoned that since the claims were for an invasion of privacy, protecting the emotional wounds and embarrassment of being thrust into the public eye, only private persons could claim an unauthorized use of their name and likeness in commerce.<sup>24</sup> Most courts held that a remedy for the tort was only available to those individuals who had not willingly placed themselves in the public eye.<sup>25</sup>

Therefore, since celebrities were already in the "public eye", courts held that there could be no invasion of privacy. In essence, celebrities had forgone the right to retain a

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<sup>21</sup> Roberson v. Rochester Folding Box Co., 171 N.Y. 538 (1902).

<sup>22</sup> Cirino, *supra* note 20, at 771-772.

<sup>23</sup> *See Id.* at 771-774.

<sup>24</sup> PETER B. MAGGS & ROGER E. SCHECHTER, TRADEMARK & UNFAIR COMPETITION LAW 614, 622 (Sixth ed. West Group 2002) (1950); J. Thomas McCarthy, Melville B. Nimmer Symposium: Article: Melville B. Nimmer and the Right of Publicity: A Tribute, 34 UCA L. R. EV. 1703, 1705-1706 (1987).

<sup>25</sup> MAGGS & SCHECHTER, *supra* note 24, at 622.

private life, apart from the public one. Further complicating the matter was the fact that courts were unwilling to differentiate between the usual claims for an invasion of privacy by a private individual – embarrassment and indignity – and those pertaining to celebrities – commercial misappropriation.

Celebrities were not arguing that the invasion was unwelcome, but simply that the publicity was uncompensated.<sup>26</sup> Yet, courts were adamantly unwilling to entertain this contention, even going as far as implying that a celebrity’s “greed” did not deserve judicially endorsed monetary protection. In particular, the Fifth Circuit, later a strong protector of the right of publicity, rejected a famous athlete’s invasion of privacy claim, when his picture was used in an advertising calendar for beer, stating that “the publicity he got was only that which he had been constantly seeking and receiving.”<sup>27</sup>

Although the Fifth Circuit was unwilling to encapsulate a celebrity’s remunerative claim under the invasion of privacy argument, several commentators began to endorse the validity of such a cause of action. As one of the foremost legal commentators on the right of publicity J. Thomas McCarthy expressed:

Privacy law seemed unable to accommodate the view that human identity constituted an intellectual property right with commercial value measured by supply and demand in the advertising and promotion marketplace. The situation was ripe for a break in traditional thinking.<sup>28</sup>

This break in traditional thought came to fruition in the form of the Haelen decision, as well as a highly acclaimed article by William Prosser.

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<sup>26</sup> Waller, *supra* note 15, at 60.

<sup>27</sup> O’Brien v. Pabst Sales Co., 124 F.2d 167, at 170 (5th Cir. 1941).

<sup>28</sup> J. Thomas McCarthy, Melville B. Nimmer Symposium: Article: Melville B. Nimmer and the Right of Publicity: A Tribute, 34 UCLA L. REV. 1703, at 1706 (1987).

## ii. Property Law Origins

Half a century of statutory law and jurisprudence, since Warren and Brandeis first introduced the concept of a tort for the invasion of privacy, a developed body of law, wholly on the state level, had become significant, yet disorganized. Under this landscape, Professor Prosser posited that the concept of privacy law - the right to be let alone - actually encompassing four distinct torts:

- (1) Intrusion upon the plaintiff's seclusion or solitude, or into his private affairs.
- (2) Public disclosure of embarrassing private facts about the plaintiff.
- (3) Publicity which places the plaintiff in a false light in the public eye.
- (4) Appropriation, for defendant's advantage, of the plaintiff's name or likeness.<sup>29</sup>

Prosser further defined the fourth tort as the "exploitation of attributes of the plaintiff's identity."<sup>30</sup>

Written several years after the Haelan decision, Prosser's argument unequivocally relied on Judge Frank's recognition of a right of publicity rooted in property law.

Defining the right of publicity as "the right of a man in the publicity of his likeness",

Judge Frank explained that:

Many prominent persons...far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements...This right of publicity would usually yield no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.<sup>31</sup>

Interestingly, Judge Frank's opinion echoed the celebrities' contention for protection under privacy laws, not for potential public indignity, but for the commercial and uncompensated misappropriation of their name or likeness. The Haelan decision's endorsement of a viable right of publicity claim under property law found further

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<sup>29</sup> William M. Prosser, Privacy, 48 Cal. L. Rev. 383, 385 (1960).

<sup>30</sup> *Id.* at 383.

<sup>31</sup> Haelan, 202 F.2d 866, at 868.

endorsement the following year in renowned intellectual property scholar Melville Nimmer. Nimmer postulated that there exists “the right of each person to control the profit from the publicity values which he has created or purchased.”<sup>32</sup>

Nimmer’s argument recognized an independent, common law right protecting economic rather than the personal, emotional interests associated with the right of privacy. Underlied with property law principles, Nimmer reasoned that significant commercial value exists in a celebrity’s name or likeness because of the considerable time, money and effort expended in building such value.<sup>33</sup> Consequently, in conformity with John Locke’s labor theory, something of value is entitled to the fruits of its economic gain. In short, celebrities, and arguably non-celebrities alike, should be given the exclusive right to prevent the unauthorized commercial misappropriation of their name and likeness.

The California Supreme Court, in Lugosi v. Universal Pictures,<sup>34</sup> decided one year after Prosser’s article, further embedded in jurisprudence the existence of a common law right of publicity as rooted in property law. In Lugosi, the plaintiff-heirs of famed actor Bela Lugosi sought to recover profits from Universal for its licensing of the Count Dracula character in subsequent films.<sup>35</sup> Lugosi, aside from portraying the protagonist Dracula, had produced the original motion picture in 1931. The plaintiff’s argued under a right of publicity claim that Universal had misappropriated Lugosi’s likeness to merchandise Count Dracula.<sup>36</sup> Relying almost entirely on Prosser’s article, the court not only held that Lugosi indeed had a proprietary interest in his likeness, but since the

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<sup>32</sup> Melville B. Nimmer, The Right of Publicity, 19 Law & Contemp. Probs. 203, at 216 (1954).

<sup>33</sup> *See Id.*

<sup>34</sup> Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979).

<sup>35</sup> *Id.* at 427.

<sup>36</sup> *Id.*

protection was linked to property law, it was descendible, thereby giving his heirs standing to bring forth a colorable claim.<sup>37</sup>

Following Lugosi, several circuits endorsed this property law based rationale for a right of publicity. Naturally, along with this justification came the proverbial “bundle of rights” associated with property, including exclusivity, assignability and descendability. The Georgia Supreme Court further integrated the right of publicity’s existence as a property right in a highly regarded case involving Dr. Martin Luther King, Jr.<sup>38</sup> In that decision, the court differentiated between what it perceived as two distinct causes of action with independent elements and rights. It held that the invasion of privacy is a personal tort that cannot be assigned or inherited.<sup>39</sup> Meanwhile, the right of publicity, now viewed under the rubric of property law, could generally be assigned and bequeathed.

Subsequent decisions also helped further define the parameters of this protection. The Sixth Circuit, in Carson v. Here’s Johnny Portable Toilets,<sup>40</sup> stated that a celebrity’s identity is valuable in the promotion of goods and therefore he “has an interest that may be protected from the unauthorized commercial exploitation of that identity.”<sup>41</sup> Furthermore, the Carson court decided not to limit the claim as to whether a name or likeness was misappropriated but whether the celebrity’s *identity* was commercially exploited. In short, the celebrity has the “exclusive legal right to control and profit from the commercial use of their name, personality, and identity.”<sup>42</sup>

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<sup>37</sup> *Id.* at 428-429.

<sup>38</sup> Martin Luther King Jr. Center For Social Change v. American Heritage Products, 250 Ga. 135 (1982).

<sup>39</sup> *Id.* at 143-144.

<sup>40</sup> Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983).

<sup>41</sup> *Id.* at 834. (“If the celebrity's identity is commercially exploited, there has been an invasion of his right whether or not his 'name or likeness' is used.”)

<sup>42</sup> Henley, 46 F.Supp.2d 587, at 590. (*citing Carson*, 698 F.2d 831)

As this article will discuss, though Carson provided broad protection, several states have either narrowly defined protectable indicia or have altogether negated its existence under common law. First, the Fifth Circuit, in Matthews v. Wozencraft, though recognizing the right of publicity, explicitly stated that the “tort does not protect the use of a celebrity’s name per se, but rather the value associated with the name.”<sup>43</sup> This decision implicitly coincides with First Amendment proponents who worry that extending right of publicity protection beyond purely commercial uses will erode freedom of speech protection.<sup>44</sup> Second, as discussed above, several jurisdictions refuse to recognize a common law right of publicity. Fueling the call for a federal statute, explicitly enumerating protected indicia of identity, these states rely wholly on conflicting statutory language, regardless of the fact that the injury is identical in all jurisdictions in which the celebrity is exploited.

The Matthews case also illustrates that right of publicity claims and sought-after remedies are perhaps better viewed as a blend between the two regimes – privacy law and property law. To that end, the court relied heavily on the Restatement (Second) of Torts 652C, which wholly incorporated Prosser’s fourth “privacy” tort: One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of privacy.<sup>45</sup> Interestingly, though the Matthews court, like many modern decisions, uses the rhetoric of “privacy”, they normally grant relief for economic rather than emotional injuries.<sup>46</sup>

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<sup>43</sup> Matthews v. Wozencraft, 15 F.3d 432, at 437 (5th Cir. 1994).

<sup>44</sup> *See generally*, Roberta Rosenthal Kwall, The Right of Publicity v. the First Amendment: A Property and Liability Rule Analysis, 70 IND. L.J. 47 (1994).

<sup>45</sup> Matthews, 15 F.3d at 437. (*citing* RESTATEMENT (SECOND) OF TORTS § 652(C) (1977)).

<sup>46</sup> MAGGS & SCHECHTER, *supra* note 24, at 623.

## **B. Right of Publicity Justifications**

As described above, the right of publicity has gone from unrecognized at the turn of the 20<sup>th</sup> Century, to finding its roots through an expanded interpretation of “privacy” law, to protecting, not only name and likeness, but, additional traits of a celebrity’s persona. Along this evolution from a privacy-based tort to a tort under property law, scholars and courts have provided numerous justifications for the existence and expansion of the right of publicity. The Tenth Circuit summarized the justifications to include: (1) providing an incentive for creativity and achievement; (2) maintaining some value to the commercial use of one’s identity by prohibiting commercial exploitation; (3) preventing consumer confusion; (4) allowing celebrities to enjoy the fruits of their labors; (5) preventing unjust enrichment; and (6) preventing emotional injuries.<sup>47</sup>

Though some rationales exist in foreign similar protection schemes, others are unequivocally contained wholly within the American legal framework. In addition, as explained below and central to this paper’s argument for an international harmonization for right of publicity protection, these justifications seemingly mirror those proffered for intellectual property rights.

### **i. Economic Justifications**

Much legal doctrine in the United States centers on economic justifications for protecting private rights. For example, and closely related to the right of publicity, one of the common arguments for expansive copyright protection is that it will further the underlying purpose of the United States Constitution and the 1976 Federal Copyright Act in encouraging the creation of original and derivative works.

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<sup>47</sup> Cardtoons v. Major League Baseball Players Ass’n, 95 F.3d 959, 973-76 (10th Cir. 1996).



This economic approach is a central justification for the right of publicity because it encapsulates: protection of market value, economic incentive, and the internalization of externalities. One of the basic assertions involves protection of the celebrity's market value. Proponents contend that since a celebrity's identity is most valuable to him, he is the entity most likely to conserve its value by fervently policing its use. In essence, celebrities can only protect the market value of their identity when self-interested entrepreneurs are prevented from exploiting it.<sup>48</sup> For example, if Michael Jordan's image has a \$1 million value, a manufacturer should not have the right to use his image, thereby receiving significant financial benefit through the siphoning of Michael Jordan's goodwill, without express consent and adequate remuneration. If people were granted such unfettered use, the value of Jordan's image would be wholly negated. Manufacturers would either use the image without paying the fair market value, or if they decided to compensate Jordan, they would almost certainly not pay the true value, \$1 million. As a result, Jordan must have the unilateral right to sell his image, en masse, in order to protect its value.

Another *raison d'être*, as discussed in the only quasi-right of publicity decision handed down by the U.S. Supreme Court, centers on a policy rationale strikingly similar to intellectual property justifications.<sup>49</sup> In Zacchini v. Scripps-Howard Broadcasting Co., the plaintiff sued after the defendant filmed his entire "human cannonball" act and, despite his objections, broadcast the footage, in toto, on the nightly news.<sup>50</sup> Finding for Zacchini, the Court held that protecting such a right would motivate the performer to

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<sup>48</sup> Dawn H. Dawson, Note, The Final Frontier: Right of Publicity in Fictional Characters, 2001 U. Ill. L. Rev. 635, 656 (2001)

<sup>49</sup> Fisher, *supra* note 9, at 99.

<sup>50</sup> Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977).

“make the investment required to produce a performance of interest to the public.”<sup>51</sup> The Court reasoned that without such protection, the performer would have no economic incentive to further his craft. In the end, the public benefits by allowing individuals to reap the rewards of their hard work.<sup>52</sup>

The Court was concerned that advertisers could free ride on the celebrity’s self-created good will, unless the right to appropriate such value was held solely by the work’s creator.<sup>53</sup> Although not specifically mentioned in the case itself, this notion is synonymous with right of publicity rationales recognizing the need to protect individuals who had created value in their name and likeness. Furthermore, it would encourage creativity and effort because individuals would wholly control the commercial exploitation of this self-created value.<sup>54</sup>

The final economic justification, considers the internalization of externalities. Proponents posit that by viewing the right of publicity as a bundle of property rights efficiency is promoted because it concentrates in the owner all the costs and benefits associated with a particular activity. As a result, the owner will fully internalize all related social costs and in doing so will defeat any externalities potentially created by third parties.<sup>55</sup>

To best illustrate this argument, imagine that Harrison Ford decides to join the National Rifle Association and is asked to promote the NRA through a series of commercial ads. Following the campaign, there is public outcry over his association and

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<sup>51</sup> *Id.* at 577.

<sup>52</sup> *Id.* at 576.

<sup>53</sup> Hayes, *supra* note 19, at 1058.

<sup>54</sup> *Id.*

<sup>55</sup> Vincent M. de Grandpre, Article, Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73, 91-92 (2001).

the value of his image is significantly reduced. Ford, therefore, will have to fully endure and internalize the costs of his own decisions. On the flip side, if he associates himself with the National Breast Cancer Awareness Association and his image's value increases significantly, he reaps the rewards from that decision. Unjustifiable externalities occur when Ford's value is either increased or decreased due to actions of someone else whom free rides off of the celebrity's good will. For example, if the NRA places Ford in an ad campaign without his authorization and as a result his value decreases, he is forced to internalize consequences of externalities. Therefore, proponents argue that such internalization promotes inefficiency because an extraneous step – NRA's unauthorized use of Ford's image – occurs in affecting the value of a celebrity's image.<sup>56</sup>

## **ii. Moral Justifications**

Courts have also justified the right of publicity from a moral perspective. In McFarland v. E & K Corp., the court held that “[a] celebrity’s identity, embodied in his name, likeness, and other personal characteristics, is the ‘fruit of his labor’ and becomes a type of property entitled to legal protection.”<sup>57</sup> This argument, also tied to Locke’s labor theory, stands for the basic proposition that if a person labors over a piece of property, thereby creating or increasing its value, that person must have the right to use that property as he sees fit. Permitting a party to capitalize on someone else’s labor would lead to morally reprehensible unjust enrichment.<sup>58</sup>

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<sup>56</sup> *Id.*

<sup>57</sup> McFarland v. E. & K. Corp., Civil No. 4-89-727, 1991 U.S. Dist. LEXIS 1496, at \*4 (D. Minn. 1991) (citing Uhlaender v. Hendricksen, 316 F. Supp. 1277, 1282 (D. Minn. 1970))

<sup>58</sup> See Fisher, *supra* note 9, at 98.

In advancing this proposition, courts have justified morally-based protection by again differentiating and balancing between publicity and privacy rights.<sup>59</sup> Celebrities can't sue for the disclosure of embarrassing facts, but can for the misappropriation of their identity to the economic advantage of another since they labored over their identity in passing from the status of a private person to one of a celebrity. While a private person remains at that status without any work, a celebrity must labor over his identity and craft in order to achieve his "public" status and that labor must be protected against unjust enrichment.

Courts also realize that a violation of this right results in a commercial injury to the business value of one's personal identity. In short, someone who has created something of value is entitled to the fruits of his economic gain without the diminution of that value by someone who was not instrumental in creating it.<sup>60</sup> As a result, the law attempts to avert the situation where in one fell swoop an intruder uses a celebrity's identity to his commercial advantage while simultaneously wholly ruining that overall value, making years of hard work null and void. To that end, some posit that moral justifications do have some roots in privacy values, affording an individual the right to associate himself with people and products of his choosing. The unauthorized use of a celebrity's name or image offends this interest because the appropriation is without the celebrity's approval.<sup>61</sup>

With these moral and economic justifications in mind, damages for infringement are calculated according to the fair market value of the plaintiff's identity, unjust

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<sup>59</sup> See Jennifer Y. Choi, Comment, No Room for Cheers: Schizophrenic Application in the Realm of Right of Publicity Protection, 9 VILL. SPORTS & ENT. L. FORUM 121, 134 (2002).

<sup>60</sup> Waller, *supra* note 15, at 61-62.

<sup>61</sup> See Fisher, *supra* note 9, at 98.

enrichment, the infringer's profits, and damage to the plaintiff's identity.<sup>62</sup> Although these remedies are an important step in protecting the celebrity's value, such misappropriation may never make the celebrity whole, and in so doing fully regaining the value of their image and name. Their years of labor will perhaps forever be tarnished quite like a private individual's reputation muddied through the dissemination of embarrassing information.

### **iii. Consumer Protection Justifications and the Lanham Act**

The final justification for the right of publicity focuses on "consumer protection", promoting the notion that an enforceable right of publicity will "protect consumers from deceptive trade practices."<sup>63</sup> Obviously the purpose of using a celebrity in an advertisement is to increase sales of the product since consumers will immediately associate the product with the celebrity. As a result, if the celebrity has created an appreciable degree of good-will, the consumer may be more apt to trust the product's quality. This value explains why companies pay the likes of Tiger Woods, Michael Jordan and George Foreman millions of dollars to endorse their products. The consumer protection argument contends that if infringers are allowed to falsely associate a trusted celebrity's name or image with their product, consumers will *mistakenly* assume that the celebrity endorsement assures a certain quality. Such misappropriation could propel consumers to buy sub-par products and, in the end, hurt the celebrity's value because of the inevitable tarnishment to their goodwill.

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<sup>62</sup> Scott L. Whiteleather, Article, Rebels With a Cause: Artists' Struggles to Escape a Place Where Everybody Owns Your Name, 21 LOY. L.A. ENT. L. REV. 253, 273 (2001).

<sup>63</sup> Waller, *supra* note 15, at 62.

In order to protect consumers, federal law specifically §43(a) of the Lanham Act prohibits any actions which may lead to confusion as to a product's origin. Section 43(a) provides that:

Any person who, on or in connection with any goods or services...uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact which –

- (1) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or;
  - (2) in commercial advertising or promotion, misrepresents the nature, characteristic, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,
- shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.<sup>64</sup>

In a § 43(a) false endorsement action, with facts similar to those underlying Midler, Tom Waits, a famous folk singer, sued for the commercial misappropriation of his voice through the use of an imitator. In Waits v. Frito-Lay, Inc.,<sup>65</sup> the defendant propositioned Waits to perform one of his songs for a commercial. However, Waits had always maintained a no endorsement policy and, therefore, rejected the offer. Insisting on using the song, the advertising company hired a singer to not only perform the song but actually imitate Waits' voice and persona. According to the facts, people were not able to differentiate between the imitator and Waits.<sup>66</sup> The court, relying heavily on Midler, applied a right of publicity analysis and held that, "When a distinctive voice of a

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<sup>64</sup> Lanham Act § 43(a), 15 U.S.C. § 1125(a) (1988).

<sup>65</sup> Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992).

<sup>66</sup> *Id.* at 1097-1098.

professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs.”<sup>67</sup> Consequently, when a celebrity’s voice is sufficient to identify him, his voice is protected against its unauthorized imitation for commercial purposes.

Analyzing legislative history, the court stated that Congress was particularly interested in protecting consumers from deception through false association and false advertising.<sup>68</sup> Accordingly, it broadly interpreted the terms listed in §43(a) to include distinctive sounds and physical appearance. As a result, the court upheld the plaintiff’s claim that the song and, particularly, how it was performed misrepresented his association with, and endorsement of, the product.<sup>69</sup>

The court acknowledged separate injury to Waits’ future publicity value (economic injury), as well as his goodwill (reputational injury) and awarded damages for each stating “the appropriation of the identity of a celebrity may induce humiliation, embarrassment, and mental distress.”<sup>70</sup> In addition, the opinion upheld the invocation of the Lanham Act as a proper vehicle against both misappropriation and deceptive advertising practices.<sup>71</sup>

Though §43(a) does provide a certain level of protection against the unauthorized commercial misappropriation of a celebrity’s name or likeness, it is important to note that significant differences exist between it and the right of publicity. First, in order to prevail in a 43(a) action, the plaintiff must demonstrate a sufficient quantum of consumer confusion. On the other hand, rights of publicity claimants have only to prove an

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<sup>67</sup> *Id.* at 1098 (*quoting* Midler, 849 F.2d at 463).

<sup>68</sup> *Id.* at 1110-1111.

<sup>69</sup> *Id.*

<sup>70</sup> Waits, 978 F.2d at 1103

<sup>71</sup> Dawson, *supra* note 48, at 646.

unauthorized use of their persona for commercial purposes.<sup>72</sup> Second, the purpose of the Lanham Act, and, in particular, §43(a) is based on providing consumers with certainty as to a product's origin. Meanwhile, publicity rights, under the rubric of property law, are concerned with protecting a celebrity's value, notwithstanding negative effects on the consumer.

### **C. Arguments Against the Right of Publicity**

In light of the abovementioned justifications for a right of publicity, several scholars have posited countervailing arguments against either the rationales for the existence of this right or, more importantly, the extent of protection.

#### **i. Arguments against the Economic Justifications**

Most critics base their arguments against the economic justifications on the assumption that, although celebrities may have some intrinsic value to their name and likeness, it is third parties that play a primary role in creating the celebrity's persona.<sup>73</sup> They contend that publicity rights, giving exclusive protection against unauthorized appropriation, overlook the roles of the media, managers, studios, photographers, and the audience, to name a few parties, in creating and enhancing a celebrity's value. Consequently, although the celebrity "labors" to a certain extent, thereby validating a property-based rationale, it is the labor of others that creates the true value.<sup>74</sup> One could even proffer that a celebrity's exclusive right of publicity leads to reverse unjust enrichment since the celebrity will financially benefit from the protection, while those most responsible for the value's creation obtain no economic rights.

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<sup>72</sup> See Grandpre, *supra* note 55, at 80-81

<sup>73</sup> Kwall, *supra* note 44, at 55; Cirino, *supra* note 20, at 793-794.

<sup>74</sup> Kwall, *supra* note 44, at 55.



In his often-cited article criticizing publicity rights, Professor Michael Madow argues that “[t]he notion that a star’s public image is nothing else than congealed star labor is just the folklore of celebrity, the bedtime story the celebrity industry prefers to tell us and, perhaps, itself.”<sup>75</sup> Professor Madow claims that not only is “fame often conferred or withheld...for reasons and on grounds other than ‘merit’”, but also that a celebrity’s image is truly controlled by the media.<sup>76</sup> In addition, Madow, and others, have posited that an unjust enrichment rationale is misplaced because celebrities will intrinsically borrow from the labor of other celebrities.<sup>77</sup>

Professor Madow’s position, however, is problematic for several reasons. First, his contention does not differentiate between overnight celebrities, like Paris Hilton, who, arguably, do little to create their value, and an athlete who trains from the age of two before achieving celebrity-status, like Tiger Woods. In both cases, although the media, management, and fans play a role in creating the persona, the life-long “labors” of Woods certainly can not be ignored. Even if third parties aided in creating the value for Woods-like celebrities, his life-long undertaking to perfect a skill serves to affirm the appropriateness in providing an exclusive right to the commercial use of his name and likeness.

In addition, Professor Madow’s contention flies in the face of basic rationales underlying both real and intellectual property law. As right of publicity advocate and expert Professor Roberta Rosenthal Kwall points out, “even if others help mold a celebrity’s image, the celebrity herself is still responsible for the vast majority of the

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<sup>75</sup> Michael Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights, 81 CAL. L. REV. 125, at 184 (1993).

<sup>76</sup> *Id.*

<sup>77</sup> See Kwall, *supra* note 44, at 55.

profit potential of her persona. Those who assist the plaintiff in creating a marketable persona typically are paid for their time and efforts.”<sup>78</sup> For example and in line with property rights, if a homeowner hires a designer to refurbish a bedroom, thereby, increasing home’s overall value, the designer does not obtain any property rights in the house itself. Normally, the designer’s sole form of compensation is a fair-value payment for his time and effort. Further illuminating Kwall’s argument is the fact that even those parties not paid by the celebrity - media and studios - derive income from capitalizing on the celebrity’s star status.

In comparison to copyright precedent, courts have consistently held that producers of a motion picture retain all the exclusive rights, as enumerated under section 106 of the 1976 Copyright Act, even though many parties are necessary, and thus employed, to technically “produce” the film. Courts have stated that giving copyrights to all parties involved in the process would lead to an unworkable system. In short, these parties are paid for their labor and thus retain no rights.<sup>79</sup> The same argument exists, if, like Professor Kwall contends, one places the right of publicity within the pantheon of copyright law so that a celebrity is the “producer”, in totality, of her image.

## **ii. Arguments against Consumer Protection Justifications**

Professor Madow identified several rationales to undercut the policy of protecting consumers from deceptive trade practices via an exclusive right of publicity. He posits that:

- 1) In selecting a product, “most consumers probably think less and care less about licensing arrangements between celebrities and advertisers”

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<sup>78</sup> *Id.* at 56.

<sup>79</sup> See Effects Associates v. Cohen, 908 F.2d 555 (9th Cir. 1990); Lindsay v. RMS Titanic, 52 U.S.P.Q.2d 1609 (S.D.N.Y. 1999).

- 2) It is not clear that consumers a priori link endorsement with celebrity merchandise
- 3) Undesirability of permitting advertisers of dangerous and shoddy product to manipulate consumers by exploiting powerful celebrity images.<sup>80</sup>

In short, “the right applies even absent a danger that consumers will be misled into believing that there is an association of, or endorsement by, the publicity plaintiff of a particular product.”<sup>81</sup>

Professor Madow’s arguments are dubious when analyzed under the current state of marketing and merchandising in our global society. It is difficult to comprehend why Nike would sign athletes to multi-million dollar endorsement contracts if the value of their image did not induce an association in the consumer’s mind between the endorsement and the product’s quality.<sup>82</sup> No logical argument exists for the expenditure of such capital if not for a profitable return based on a persona-quality association. In addition, many athletes are contractually obliged to use the products they endorse. Since an athlete’s performance would diminish with the use of inferior equipment, this furthers the argument that the product is not only of a high quality, but that consumers will associate the endorser with the good.

Furthermore, if such an association exists, the justification for an exclusive right to control one’s image in order to avoid consumer confusion is made that much stronger. For example, if Nike pays Tiger Woods to endorse and use a particular set of golf clubs bearing his name, and yet a third party can simply appropriate Woods’ name, without authorization, for an inferior set of clubs, consumer will have difficulty differentiating

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<sup>80</sup> Madow, *supra* note 75, at 228-229.

<sup>81</sup> Kwall, *supra* note 44, at 55.

<sup>82</sup> Lebron Gets \$90 Million in Nike Deal, Associated Press (May 23, 2003), *available at* [http://www.enquirer.com/editions/2003/05/23/spt\\_wwwlebronnike.html](http://www.enquirer.com/editions/2003/05/23/spt_wwwlebronnike.html); Woods Reportedly Set to Sign \$100 Million Deal with Nike, Associated Press (Sept. 14, 2000), *available at* [http://sportsillustrated.cnn.com/golf/news/2000/09/14/tiger\\_nike\\_ap](http://sportsillustrated.cnn.com/golf/news/2000/09/14/tiger_nike_ap).

which product bears an authentic endorsement. Not only would this economically injure the consumer who makes a confusion, which arguably was the competitor's intent, but Woods' image is economically injured because those consumers will associate his name with a product of inferior quality. As the Supreme Court of California stated "...Entertainment and sports celebrities are the leading players in our Public Drama...We copy their mannerisms, their styles, their modes of conversation and of consumption"<sup>83</sup>

## **Part II – Right of Publicity in California and New York**

Due to the lack of a comprehensive federal scheme, potential right of publicity plaintiffs must rely on divergent state law and precedent. Consequently, publicity right claims brought in different states and, yet, alleging the same misappropriation will not receive a consistent remedy, if at all. Although twenty-seven states now protect, in one form or another, the right of publicity, this article will concentrate on the two most influential, yet highly discordant states: California and New York. For the sake of comparison and inclusion, this section will also briefly discuss the protection schemes in existence in Tennessee and Indiana, the latter of which is often considered the most aggressive and well-defined statutory scheme in the United States.

### **A. California**

As one would expect, California state courts, as well as the Ninth Circuit have provided rich and influential jurisprudence defining the extensions and limitations on the right of publicity. In addition to a detailed statutory scheme, the courts have explicitly

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<sup>83</sup> Comedy III Productions, Inc. v. Saderup, 25 Cal. 4th. 387, at 397 (2001).

indoctrinated a broadly-defined common law publicity right. Entertaining such a common law action was instrumental in the Midler decision.

### **i. Statutory Scheme**

One weapon potential plaintiff's have at their disposal in a right of publicity action is section 3344 of the California Civil Code. Enacted one year after, and in close conformity with, William Prosser's article enunciating four distinct privacy law torts, section 3344(a) of the Code embodies the law regarding the appropriation of name and likeness for commercial purposes. It states in pertinent part:

Any person who knowingly uses another's name, voice signature, photograph or likeness, in any manner,...for purposes of advertising or selling...without such person's prior consent...shall be liable for any damages sustained by the person or persons injured as a result thereof.<sup>84</sup>

Several significant characteristics of the statute are worth mentioning. First, it enumerates a person's protectable traits - name, voice, signature, photograph and likeness. Courts have interpreted the legislature's intent in specifying protected traits as creating an absolute list. Consequently, the Midler court dismissed her statutory claim because Ford did not actually use her voice in the commercial, but simply hired someone to imitate it.<sup>85</sup>

Second, the statute only protects knowing uses of the enumerated indicia. Therefore, unlike the common law, mistake and inadvertence are viable defenses against claims of commercial misappropriation.<sup>86</sup> Finally, section 3344(g) of the statute stipulates that the statutory remedies "are cumulative and shall be *in addition* to any

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<sup>84</sup> Cal. Civ. Code § 3344(a) (West 1997).

<sup>85</sup> Midler, 849 F.2d 460, 463.

<sup>86</sup> Cal. Civ. Code § 3344(g) (West 1997); Cirino, *supra* note 20, at 780.

others provided for by law.”<sup>87</sup> (emphasis added) This section implies that a court may entertain a common law right of publicity claim, providing a remedy for the misappropriation of indicia in addition to those stipulated in the statute. It is on this basis that the Midler court affirmed her cause of action.<sup>88</sup>

## **ii. Common Law**

Unlike the traits enumerated under 3344(a), the common law right of publicity embraces an expansive, yet ultimately ambiguous, set of indicia. It is precisely the court’s plaintiff-generous extension of protectable indicia that has significantly expanded a celebrity’s exclusive right to control the commercial use of their identity, arguably, in toto.

In White v. Samsung,<sup>89</sup> the Ninth Circuit held that the California common law right of publicity includes “appropriations of identity” that extend beyond name and likeness protection, as provided under 3344(a), and includes the “unauthorized use of attributes that leave no doubt as to whom the attributes belong to.”<sup>90</sup> Though decided several years after Midler, the majority opinion in White, in extending protected indicia, helps explain the Midler court’s decision to protect her voice from imitator misappropriation.

Since Midler and White, the opinions’ influence is evident from the long line of decisions expanding the purview of common law publicity right protection. As Midler implies, a defendant’s appropriation of *any* aspect of a plaintiff’s persona may lead to

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<sup>87</sup> Cal. Civ. Code § 3344(g) (West 1997).

<sup>88</sup> See Midler, 849 F.2d 460.

<sup>89</sup> White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992)

<sup>90</sup> Cirino, *supra* note 20, at 785 (citing White, 971 F.2d 1395, 1398-1399).

liability so long as the plaintiff is clearly identifiable.<sup>91</sup> However, Midler's progeny have also led to stinging dissenting opinions from Judge Kozinski, a right of publicity expert.

Judge Kozinski's dissenting opinion in White suggests that the common law right would inappropriately extend to anything that "evokes" a celebrity's personality.<sup>92</sup> Judge Kozinski, among others, fear that White would provide courts with unbridled discretion based on subjective and unpredictable standards defining what constitutes a celebrity's "personality".<sup>93</sup> Even more problematic, in terms of consistent jurisprudence, is the fact that indicia of identity evoking a celebrity's personality, giving light to a colorable claim, will differentiate between plaintiffs. Notwithstanding Judge Kozinski's well-grounded apprehensions on the negative effects of an expansive right of publicity protection, the White decision reflects the jurisdiction's historical willingness to protect traits beyond those enumerated in 3344(a). In this author's opinion, the Ninth Circuit's natural expansion of common law protection is vital because celebrities will have intrinsic value for unique aspects of their overall persona. Through the years these indicia have included an athlete's association with a distinctive racecar,<sup>94</sup> a slogan or phrase closely linked with a talk show host,<sup>95</sup> nicknames,<sup>96</sup> protection of vocal style,<sup>97</sup> and, perhaps, protection over fictional characters directly evoking the actor.<sup>98</sup>

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<sup>91</sup> MAGGS & SCHECHTER, *supra* note 24, at 630. It is important to note that the same language, requiring clear identifiability, appears in §3344(b)(1), further defining §3344(a)'s parameters.

<sup>92</sup> *See White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514-1516 (1993) (Kozinski, J. dissenting)

<sup>93</sup> *See Id.*

<sup>94</sup> Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, at 824 (9th Cir. 1974).

<sup>95</sup> Carson, 698 F.2d 831.

<sup>96</sup> Hirsch v. S.C. Johnson & Sons, Inc., 90 Wis.2d 379 (1979).

<sup>97</sup> Waits, 978 F.2d 1093.

<sup>98</sup> Wendt v. Host International, Inc., 197 F.3d 1284, 1285 (9th Cir. 1999).

Since Midler, the Fifth Circuit has also unequivocally recognized the common law tort of misappropriation protecting the unauthorized use of one's name, image or likeness.<sup>99</sup> In conjunction with the Ninth Circuit decisions, this is important because it will, to some degree, harmonize common law right of publicity jurisprudence, thereby providing a certain semblance of certainty to right-holders and advertisers, alike. It is important to note that the Fifth Circuit decisions explicitly discussed Waits and Midler in assessing the plaintiff's common law claims. As a result, one can argue that not only are jurisdictions willing to entertain right of publicity decisions from foreign jurisdictions, but also that they regard the Ninth Circuit as a sort of torchbearer.

## **B. New York**

Not every jurisdiction is willing to recognize a common law right of publicity. New York courts, since 1903, have consistently denied the existence of such a right.<sup>100</sup> The state court's reluctance to recognize common law protection right is perplexing since Haelen, a Second Circuit decision, was instrumental in spearheading common law publicity rights. The lack of harmonization between state and federal courts in the same jurisdiction, unfortunately, results in further ambiguity and murkiness.

### **i. Statutory Protection**

New York state courts have held that the state publicity statute is the sole source of protection for parties asserting right of publicity claims.<sup>101</sup> This line of jurisprudence began in 1903 when the state's highest court decided Roberson v. Rochester Folding Box

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<sup>99</sup> Brown v. Ames, 201 F.3d 654 (5th Cir. 2000) (citing Moore v. Big Picture Co., 828 F.2d 270, 275 (5th Cir. 1987)).

<sup>100</sup> Brinkley v. Casablancas, 80 A.D.2d 428 (1981).

<sup>101</sup> Stephano v. News Group Publications, Inc., 474 N.E.2d 580 (1984).



Company.<sup>102</sup> In Roberson, the Franklin Mills Corporation printed 25,000 posters featuring the plaintiff-teenager. These advertisements were hung in stores and saloons and caused “great humiliation by...scoffs and jeers.”<sup>103</sup> The plaintiff, under a theory of unauthorized use of her photograph, a claim of first impression in the jurisdiction, sought \$15,000 in damages for injury to reputation. She also sought an injunction against further dissemination of her picture.<sup>104</sup>

The court of appeals, in a narrow 4-3 decision, sided with “well-settled” principles of law guiding the advertising profession and refused to accept the existence of a proper claim under the common law rubric for the right of privacy. The court noted, somewhat prophetically, that “the legislative body could very well interfere and arbitrarily provide that no one should be permitted for his own selfish purpose to use the picture or the name of another for advertising purposes without his consent.”<sup>105</sup> Taking the bull by the horn, the state legislature responded to the decision as suggested.

The same year as the appellate court handed down Roberson, the New York State legislature enacted sections 50 and 51 of the Civil Rights Law. Although codified as a privacy statute, the law protects against the unauthorized use of a person’s “name, portrait or picture” for advertising purposes.<sup>106</sup> Due in large part to the legislative decision to enact sections 50 and 51, courts have expressly affirmed the Roberson holding that a common law right of publicity does not exist, thereby, relegating protection solely to the statute.<sup>107</sup>

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<sup>102</sup> Roberson v. Rochester Folding Box Company, 171 N.Y. 538 (1902)

<sup>103</sup> *Id.* at 542-543.

<sup>104</sup> *Id.* at 543.

<sup>105</sup> *Id.* at 545.

<sup>106</sup> N.Y. Civ. Rights Law §§ 50 & 51 (McKinney 1992).

<sup>107</sup> See Stephano, 474 N.E.2d 580, 584.

Although it is argued that New York state courts have liberally interpreted the statute's "name, picture, or portrait" language, to permit claims of likeness misappropriation, they have never recognized a common law right found valid under Haelan.<sup>108</sup> Broadly interpreting the statutory language, state courts have permitted recovery for depictions of celebrities that are easily recognizable. However, they have never construed the statute so liberally as to permit recovery for appropriations of voice (Midler) or personal attributes (White).<sup>109</sup> It is of course important to remember that the California courts were also unwilling to extend statutory protection for imitated voice and personal attribute misappropriation, limiting the respective plaintiff's remedial grounds to the more liberal common law.

As one can easily imagine, the national pervasiveness and dissemination of advertising, accomplished almost instantly with the developments in broadband technology, can cause many issues for right of publicity claimants in light of New York jurisprudence. For a plaintiff like Midler, though she could seek relief in California, as well as several other states, her case would lose in New York because of the court's unwillingness to entertain either a common law right of publicity claim or to extend the statute's language to voice misappropriation. Moreover, several post-Haelan Second Circuit decisions, decided under New York law, are looking solely to section 50 and 51 for applicable protection guidelines.<sup>110</sup> Consequently, although the claimant's injury is felt nation-wide, her redressable claims are limited to specific jurisdictions which may not award her damages for acts occurring outside the jurisdiction itself. It also requires

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<sup>108</sup> See Cirino, *supra* note 20, 775-777.

<sup>109</sup> See generally Cirino, *supra* note 20.

<sup>110</sup> See Pirone v. MacMillian, Inc., 894 F.2d 579, 586 (2nd Cir. 1990) ("The New York courts have indicated clearly that the Civil Rights Law preempts any common law right of publicity action...").

plaintiffs, residing in states like New York, to file a claim in a California-like jurisdiction although the injury partially occurs in their home state.

### **C. Tennessee**

Tennessee's right of publicity law was the birth child of a series of cases, as well as liberal legislatures, of the state's favorite son: Elvis Aron Presley.<sup>111</sup> Initially, Presley's estate, those entrusted to ensure that they pre-approve and license all memorabilia featuring "The King" and manufactured by third parties, lost a convoluted yet highly influential decision at the Second Circuit. In Factors, Etc. v. Pro Arts, the Second Circuit concluded that as a choice of law matter, Tennessee law was to apply. The problem for the plaintiff was that the Tennessee state courts, as well as the Sixth Circuit, which has federal jurisdiction over Tennessee, previously held that the right of publicity did not exist under common law. Consequently, since the Second Circuit elected to apply Tennessee law, coupled with the fact that no relevant statute existed at the time, the court ruled against Factors, Etc.<sup>112</sup>

The estate's fiduciary quickly realized the enormity of the situation and, specifically, the overwhelming monetary and moral implications of the decision. As a result, Presley's estate decided to wage a two-pronged attack, through the legislature, as well as the courts.<sup>113</sup>

At the state appellate court level, in State ex. rel. Elvis Presley Int'l Mem'l Fund v. Crowell, the court held that, in fact, Tennessee did recognize a common law right of

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<sup>111</sup> Factors Etc., Inc. V. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978); Factors Etc., Inc. V. Pro Arts, Inc., 652 F.2d 278 (2d Cir. 1981); Memphis Dev. Found. v. Factors Etc., Inc., 616 F.2d 956 (6<sup>th</sup> Cir. 1980).

<sup>112</sup> See Factors Etc., Inc. V. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978); See Factors Etc., Inc. V. Pro Arts, Inc., 652 F.2d 278 (2d Cir. 1981)

<sup>113</sup> See W. Mack Webner and Leigh Ann Lindquist, Transformation: The Bright Line Between Commercial Publicity Rights and the First Amendment, 37 AKRON L. REV. 171, 177-178 (2004).

publicity.<sup>114</sup> The next month, the Sixth Circuit, in Elvis Presley Enters. v. Elvisly Yours, reversed its own decision and held that since a state court rejected the non-existence of a common law right of publicity, it was bound to follow that court's decision.<sup>115</sup> It is certainly interesting to note that not only did the Sixth Circuit's decision in Elvisly come merely seven years after the Factors decisions, but that the court wholly disregarded the doctrine of stare decisis and simply, or conveniently, followed the ruling of a state court over which no jurisdiction exists. As Eric Goodman states, "States without such special interests are less likely to have strong right of publicity laws."<sup>116</sup>

As the legislative level, the estate successfully helped pass the state's first right of publicity statute, which, interestingly, strongly mirrored the federal trademark statute – The Lanham Act. Federal trademark protection for the Elvis name was possible by this time because the singer/actor's name had attained sufficient distinctiveness, necessary for such protection.<sup>117</sup> With a trademark on the name, the estate could prevent, through federal means, the unauthorized reproduction of Elvis' name and portrait on or in connection with any goods or services for which they had obtained registration.

Not only did the use of trademark language provide the estate with incredibly broad protection in itself, but another aspect of trademark law made the Tennessee statute wholly distinctive from those of other states: length of protection. In accordance with the Lanham Act, the Tennessee right of publicity statute provides, theoretically, perpetual protection. It declares that the right continues for so long as it is not abandoned.<sup>118</sup> As

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<sup>114</sup> State ex. rel. Elvis Presley Int'l Mem'l Fund v. Crowell, 733 S.W.2d 89, 97 (Tenn. Ct. App. 1987).

<sup>115</sup> Elvis Presley Enters. v. Elvisly Yours, 817 F.2d 104 (6<sup>th</sup> Cir. 1987).

<sup>116</sup> Eric Goodman, A National Identity Crisis: The Need for a Federal Right of Publicity Statute, 9 DEPAUL-LCA J. ART & ENT. L. & POL'Y 227, at 239 (1999).

<sup>117</sup> See Webner, *supra* note 113, at 177-178; *Tenn. Code Ann.* 47-25-1101 to 47-25-1108 (2005).

<sup>118</sup> *Tenn. Code Ann.* 47-25-1104 (2005).

such, the right is also descendible and transferable. The perpetual protection under Trademark law, demarcates one of the greatest differences between that law and Copyright, since the latter protects works for a limited time. When evaluating in which intellectual property scheme the right of publicity best fits, if either, the length of protection must remain one of the most important factors.

#### **D. Indiana**

Such “special interests” were probably also at play in Indiana, which in 1998 passed one of the most comprehensive, progressive, and detailed right of publicity statutes in the country.<sup>119</sup> Highly encouraged by CMG Worldwide, an Indiana-based talent agency, the statute protects individuals under Indiana state law “regardless of a person’s domicile, residence, or citizenship.”<sup>120</sup> Consequently, any infringing material crossing into Indiana would open up the infringer to a right of publicity action within the state, regardless of whether the potential-plaintiff actually resided within the state’s borders.

Although the issue is beyond this paper’s scope, one of the main problems with this language is determining what is to be regarded as activity within the state. Does infringing material that fortuitously enters the state, through no explicit action of the infringer create a viable claim? Or does the plaintiff need to demonstrate that the infringer intentionally sent the materials into the state? In further analyzing this issue, one must consider, in the context of the pervasiveness of the Internet, if whether a claim in Indiana exists when someone in the state simply accesses a website, with a server not physically in the state, but nonetheless consisting of infringing material.

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<sup>119</sup> *Ind. Code Ann.* 32-36-1-1 to 32-36-1-20 (2006) (original statute *Ind. Code Ann.* 32-13-1-1 to 32-13-1-20 was repealed by P.L.2-2002, § 128, effective July 1, 2002).

<sup>120</sup> *Id.* At 32-36-1-1(a).

## **E. Protection of the Non-Famous, Descendability & Transferability**

Prior to discussing the methods of protection for publicity rights, if any, in foreign countries, several additional considerations exist regarding the extent of protection, both in the United States and abroad. First, although the majority of right of publicity discussions is celebrity-centric, most, if not all, applicable state statutory laws, as well as common law decisions, do not require fame as a precursor to protection. Second, the issue of the descendability and transferability of this property right, as discussed in Lugosi, has received significant attention because it would extend protection well beyond the life of the subject and protect personal value that, arguably, no longer exist.

### **i. Protection of the Non-Famous**

Though mostly posited to protect the value of a *celebrity*'s image, the right of publicity can extend to protect persons whose image has no intrinsic value at the time of the misappropriation. Professor J. Thomas McCarthy, a preeminent right of publicity scholar, argued in his oft-cited thesis on the subject that the protection is not limited to the famous.<sup>121</sup> Steven Getzoff, chair of the American Bar Association ("ABA") taskforce on federalizing a right of publicity, stated that "traditionally, the right of publicity was considered only available to famous people....he [McCarthy] blew all of us away by asserting that everyone has a right of publicity, irrespective of whether they were famous."<sup>122</sup>

The protection of the non-famous, via the right of publicity, though rare, demonstrates the willingness of courts and legislatures to protect private individuals against both the moral improprieties resulting from the misappropriation, as well as the

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<sup>121</sup> See J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 4:15 (1987).

<sup>122</sup> Hamilton, *supra* note 10, at 227.

right to redress the increase in image-value, ex post facto. Therefore, a “private” plaintiff may seek redress for privacy-type reputational harms or property-type economic injury.<sup>123</sup> As several cases, discussed below, impliedly hold, the fact that the person’s likeness at the time of misappropriation has no celebrity-esque value will not serve as a bar to remedy if the unauthorized use was for commercial gain, which, arguably, creates the requisite value.

In Mendonsa v. Time Inc.,<sup>124</sup> the defendant offered for \$1,600 copies of a famous picture featuring a sailor kissing a nurse on V-J Day. Although Time had originally published the picture in 1945, in its newspaper, and had subsequently republished it, the defendant’s decision to sell the pictures in 1987 brought about the action for misappropriation of likeness.<sup>125</sup> Though not a celebrity in his own right, the plaintiff’s picture had achieved considerable fame, and, thus created value in his image. This proposition is clearly demonstrated by the fair market value the defendant sought for the pictures. The Rhode Island court denied the defendant’s motion to dismiss not because of the intrinsic value in the plaintiff’s image, but because of the purely commercial nature of the sale.<sup>126</sup> The court also clearly stated that non-commercial uses of the picture, and, therefore, likely protected under the First Amendment, would not justify an action for a right of publicity.<sup>127</sup> Therefore, prior to selling the picture for commercial purposes, Time was required to obtain Mendonsa’s consent. However, if Time wished to reproduce the image in a news-style setting, consent was not required since the First Amendment protected the use.

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<sup>123</sup> See McCarthy, *supra* note 121, at § 4:15.

<sup>124</sup> Mendonsa v. Time Inc., 678 F.Supp. 967 (D.R.I. 1988).

<sup>125</sup> *Id.* at 968-969.

<sup>126</sup> *Id.* at 973.

<sup>127</sup> See *Id.* at 972.

The Mendonsa decision demonstrated the court's departure, in cases involving non-famous individuals, from what the Carson decision described as a "cause of action...to protect a celebrity's identity, which can be valuable in the promotion of products"<sup>128</sup> to an analysis focusing on the commercial use of the likeness. This shift is directly in line with the Restatement (Second) of Torts § 652C stating that if a defendant appropriates a person's name or likeness to his commercial advantage, he derives a direct benefit from the use.<sup>129</sup> Furthering this interpretation, the United States District Court for the Northern District of Texas, in Henley v. Dillard Department Stores, stated that "[t]he plaintiff in a right of publicity action is not required to show that the defendant made money off the commercial use....What Plaintiff must prove is that Defendant received a commercial benefit...he would otherwise not have received."<sup>130</sup> The court described the benefit to advertisers as "being able to catch the eye of the consumer and make the ad more interesting."<sup>131</sup>

New York courts have also protected the non-famous from unauthorized commercial use of their "name, picture, or portrait", in accordance with Sections 50 and 51 of the Civil Code. As previously noted, the New York courts rely solely on the statutory law for right of publicity protection that does not require pre-existing fame. Unauthorized use in advertising or in trade is the sole value-related prerequisite in the statute's language. In Beverly v. Choices Women's Medical Center Inc., the court held that the inclusion of a doctor's photograph in a calendar advertising medical services was

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<sup>128</sup> Henley, 46 F.Supp.2d at 597 (citing Carson, 698 F.2d at 835)).

<sup>129</sup> RESTATEMENT (SECOND) OF TORTS § 652(C) (1977).

<sup>130</sup> Henley, 46 F.Supp.2d 587, at 597.

<sup>131</sup> *Id.* at 596.



actionable under Sections 50 & 51.<sup>132</sup> Although the court acknowledged the public interest message underlying the calendar, it found that the photograph was used for advertising purposes.<sup>133</sup>

As noted, the plaintiff must demonstrate that the defendant's use of the name or likeness was for commercial purpose. This element is a prerequisite regardless of whether the case is brought under privacy protection for emotional harm or for economic injury under the rubric of the right of publicity. In Tellado v. Time-Life Books, Inc., the plaintiff sued because of the emotional trauma felt as a result of seeing his photograph, taken while he was serving in Vietnam, on promotional materials for a series of books about the war.<sup>134</sup> The court, siding with the plaintiff, determined that if the "defendant simply used the plaintiff's picture in a book to depict the history of the Vietnam War, the use would have been privileged by the First Amendment, regardless of the profit motive underlying the book."<sup>135</sup> However, it reasoned that the defendant had to provide compensation for the "individual whose likeness is helping to stimulate those profits."<sup>136</sup> Instead of affording First Amendment protection for the entire project, the court differentiated the purpose, and thus, protection of the two mediums – advertisements and books. While the latter was perceived as constitutionally protected, the former was of a purely commercial nature, thereby requiring authorization and remuneration.<sup>137</sup> In all of these cases, the plaintiff's status as a non-celebrity was not a bar to recovery.

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<sup>132</sup> Beverley v. Choices Women's Medical Center Inc., 587 N.E.2d 275 (N.Y. 1991)

<sup>133</sup> *Id.* at 279.

<sup>134</sup> Tellado v. Time-Life Books, Inc., 643 F.Supp. 904 (D.N.J. 1986).

<sup>135</sup> Kwall, *supra* note 44, at 98 (*citing* Tellado, 643 F.Supp. 904, 914.)

<sup>136</sup> *Id.*

<sup>137</sup> *See* Tellado, 643 F.Supp. 904, 913-914).

Interestingly, based on precedent, and, in particular Tellado, one could argue that non-famous people have a broader right of publicity protection than celebrities. This distinction exists because a private person can bring a colorable right of publicity claim for emotional, as well as economic injury. As previously discussed, several courts have held that celebrities can not bring a right of publicity claim based solely on injury to reputation because they have voluntarily placed themselves in the public light, thus forgoing their “private person” status. However, the same does not hold for a non-celebrity who never voluntarily entered the public arena. This proposition rests on the Tellado decision which held that the advertisements violated the plaintiff’s right of publicity because of its commercial nature. It is important to remember that the brunt of Tellado’s alleged injury rested on emotional harm, and not economic injury. Therefore, one can postulate that a private individual retains their “private” status, giving rise to a right of publicity claim for reputational and emotional harm resulting from the commercial use of his name or likeness – a remedy not available for celebrities.

## **ii. Descendability and Transferability**

Aside from protection of the non-celebrity, courts have grappled with the issue of descendability and transferability when it came to publicity right protection. Can an heir sue for the commercial misappropriation of a deceased’s name and likeness? As discussed, identity rights have been deemed both a personal right and a property right, under privacy law and the right of publicity, respectively.

As a personal right, it is akin to defamation, and usually limited to living persons. As a property right, courts and state legislatures have had to decide whether it is descendible, like other property, as an asset of the estate upon the death of a person,

under the law of the jurisdiction where the deceased was domiciled at the time of his or her death. “Once you call something a right of publicity, then essentially it becomes a commodity for trade, and a commodity survives its creator.”<sup>138</sup>

Courts which perceived publicity rights under the rubric of privacy tended to regard the right as personal, and, consequently, incapable of surviving death. On the other hand, courts interpreting the right under the property model were inclined to permit descendability. Some courts have even intimated that the right is inheritable only if it was exploited during the person’s lifetime. However, this latter opinion is divergent from Professor McCarthy who surmises that “the overwhelming majority rule under either statute or common law is that the right of publicity is descendible property and has a postmortem duration which is not conditioned on lifetime exploitation.”<sup>139</sup>

As previously mentioned, Justice Bird’s decision in Lugosi was the first explicit recognition of an inheritable right of publicity. Although not making a determination on the actual merits of the case, Justice Bird denied the defendant’s motion to dismiss and held that Lugosi’s heirs had made a colorable and proper right of publicity claim. After Lugosi, the California legislatures enacted California Civil Code 3344(g), now California Civil Code 3344.1, to further cement post-mortem rights, as well as resolve any ambiguity created by subsequent Lugosi-esque decisions.<sup>140</sup> Of particular note, the statute does not require that the deceased have used his name or likeness during his lifetime in order for heirs to obtain rights.

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<sup>138</sup> Hamilton, *supra* note 10, at 227-228.

<sup>139</sup> McCarthy, *supra* note 121, at § 9:17.

<sup>140</sup> See Cal. Civ. Code § 3344.1 (West 2000). (The entire interest in those rights belongs to the surviving spouse of the deceased personality unless there are any surviving children or grandchildren of the deceased personality, in which case one-half of the entire interest in those rights belong to the surviving spouse.).

The Tennessee Court of Appeals, in the above-mentioned case involving the Elvis Presley International Memorial Foundation, articulated several justifications for a descendible right.

- 1) it promotes an individual's right to testamentary distribution
- 2) prevents unjust enrichment
- 3) promotes a celebrity's expectation that she is creating something of value to pass on to her heirs and assigns after her death
- 4) promotes the expectation of any licensees with whom the celebrity might have contracted, and
- 5) furthers the public interest in truthful representations regarding sponsorship of goods<sup>141</sup>

It is interesting to note, and furthers the recognition of the right of publicity as a neighboring right to intellectual property, that the majority of these justifications are synonymous with those expressed for copyright and trademark protection.

Federal court decisions have also found the right descendible. In a much celebrated case involving Dr. Martin Luther King Jr.'s wife Coretta Scott King, the 11<sup>th</sup> Circuit explicitly held that: 1) the image of Dr. King was inheritable, and; 2) exploitation during his lifetime was not a prerequisite for protection.<sup>142</sup> The court stated "[i]f the right of publicity dies with the celebrity, the economic value of the right of publicity during life would be diminished because the celebrity's untimely death would seriously impair, if not destroy, the value of the right of continued commercial use."<sup>143</sup> Furthermore, Dr. King's decision not to exploit his name or likeness during his lifetime was, in essence, a commercial use because such a decision constituted a financial decision.<sup>144</sup>

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<sup>141</sup> State ex rel. Elvis Presley International Memorial Foundation v. Cromwell, 733 S.W.2d 89, 97-98 (Tenn. Ct. App. 1987).

<sup>142</sup> See Martin Luther King Jr. Center For Social Change v. American Heritage Products, Inc., 694 F.2d 674, 672-676 (11th Cir. 1983).

<sup>143</sup> *Id.* at 682.

<sup>144</sup> *Id.*

However, unlike the 11<sup>th</sup> Circuit and California court precedent, among others, New York State courts have held that the rights, covered under Section 50 and 51 of the Civil Code, were not inheritable because publicity rights fell under the rubric of privacy law.<sup>145</sup> The court held that since the legislature did not explicitly carve out an inheritability exception for unauthorized commercial use of a person's "name, picture or portrait", post-mortem rights did not exist.<sup>146</sup>

In sum, a growing number of states have determined that a person's post-mortem right of publicity can be assigned while the person is living and are inheritable after death. However, the inquiry regarding inheritability also includes the, arguably, more important question as to the duration of protection during which an heir could bring a claim. In short, how long should a person's name and image remain protectable against unremunerated and unauthorized commercial use? Again, state statutes are discordant extending protection anywhere from 10 years to 100 years.<sup>147</sup> As one can understand, the lack of national conformity and the associated problems, discussed throughout this article, has fueled arguments for federal legislation.<sup>148</sup>

#### **F. Prima Facie Case**

Although major differences exist between the scope of state right of publicity protection, one important commonality exists: elements underlying a prima facie case. Essentially, as described in Eastwood v. Superior Court, a plaintiff invariably must allege, and eventually prove, 4 elements: "1) the defendant's use of the plaintiff's identity; 2) the appropriation of the plaintiff's name or likeness to the defendant's

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<sup>145</sup> Fisher, *supra* note 9, at 104.

<sup>146</sup> *Id.* (citing Pirone v. MacMillan, Inc., 894 F.2d 579, 585 (2nd Cir. 1990).

<sup>147</sup> Cal. Civ. Code § 3344.3 (70 years); Fla. Stat. Ann. §540.08(4) (40 years); Tenn. Code Ann. §47-25-1104(a) (10 years); Okla. Stat. Ann. tit. 12, §1448(G) & Ind. Code § 32-13-1-8 (100 years).

<sup>148</sup> See generally, Hamilton, *supra* note 10.

advantage, commercial or otherwise; 3) lack of consent; and 4) resulting injury.”<sup>149</sup>

Although courts have used distinct wording in their respective prima facie standards, these basic elements are common throughout.<sup>150</sup>

Substantiating the first element, use of the plaintiff’s identity, will depend almost wholly on whether the indicia of identity claimed to have been infringed is even protected in a specific state. As discussed above, California’s broad common law principles would cover elements of identity that states like New York, with its narrower statutory language, would not protect. It is also quite possible that a state recognizing right of publicity protection under common law would refuse to extend it as far as the court in White. However, since most cases involve the unauthorized use of a name or picture, “Identifiability of plaintiff will probably not be a disputable issue in the majority of meritorious Right of Publicity cases.”<sup>151</sup> It is the outlying cases, like Midler and White, which not only create wonderful theoretical debate for law school classrooms but, as evidenced by the Ninth Circuit, also create undeniable problems for the courts. Meanwhile, the third element, lack of consent, is fairly straightforward and does not require further discussion.

The second element creates several issues because of its ambiguous wording. It also permits courts to make relevant determinations on an ad hoc basis. As the court in Henley stated, “The “benefit” element requires Plaintiff to prove that Defendant derived some commercial benefit...as opposed to deriving no commercial benefit due to the fact

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<sup>149</sup> Eastwood v. Superior Court, 198 Cal. Rptr. 342, at 347 (CT. App. 1983); Cardtoons v. Major League Baseball Players Ass’n, 95 F.3d 959, 968 (10th Cir. 1996); Brown v. Ames, 201 F.3d 654, 657 (5th Cir. 654); See Matthews v. Wozencraft, 15 F.3d 432, 437 (5th Cir. 1994).

<sup>150</sup> J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1:3, :4 (2d ed. rev. Mar. 2002) at v, §3:2

<sup>151</sup> J. THOMAS MCCARTHY, 1 THE RIGHTS OF PUBLICITY & PRIVACY § 3.2 (1998).

that the use was incidental.”<sup>152</sup> Furthermore, Comment d of Restatement (Second) of Torts reads: It is only when the publicity is given for the purpose of appropriating to the defendant’s benefit the commercial or other values associated with the name or likeness that the right of privacy is invaded.<sup>153</sup> Consequently, the appropriation of the person’s name or likeness must be explicitly and directly linked to the defendant’s commercial advantage. Based on this language, the court in Polsby v. Spruill held that intent to make a profit from the publication of an ad, without proof that a profit resulted, is not sufficient to demonstrate a commercial benefit.<sup>154</sup> The court stated that the defendant must use “the name or likeness for the express purpose of appropriating the commercial benefit that is particularly associated with the name or likeness of the plaintiff.”<sup>155</sup> Consequently, as for the Polsby court, the defendant’s intent, as well as proof of a profit, no matter how small, is of crucial evidentiary importance.<sup>156</sup>

However, it appears that the Polsby court is in the minority when it comes to proving a commercial benefit. After discussing the Polsby holding, the Henley court explicitly rejected the profit requirement, refusing to require proof that a “defendant made a profit or secured a tangible benefit from the use of the plaintiff’s name or likeness”.<sup>157</sup> This reasoning is directly in line with the Fifth Circuit in Matthews, as well as *J. Thomas McCarthy*, which stated that the defendant should not be immune to liability simply because “the product promoted is undesirable, the ad [is] clumsy or somehow

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<sup>152</sup> Henley v. Dillard Department Stores, 46 F.Supp.2d 587, at 596 (N.D. Texas 1999).

<sup>153</sup> RESTATEMENT (SECOND) OF TORTS § 652C comment d. (1977).

<sup>154</sup> See Polsby v. Spruill, Civ. No. 96-1641 (TFH), 1997 U.S. Dist. LEXIS 11621 (D.D.C. Aug. 1, 1997).

<sup>155</sup> *Id.* at \*13.

<sup>156</sup> See generally *Id.*

<sup>157</sup> Henley, 46 F.Supp.2d 587, at 597.

ineffective, or sales slump[ed] during the relevant period.”<sup>158</sup> Thus, demonstrating the commercial benefit element is normally not dependent on proof of profit.

### **G. Right of Publicity and the First Amendment – The Mother of all Red Herrings**

Pundits urging the narrowing or complete elimination of a right of publicity almost universally rest their arguments, in whole or in part, on the First Amendment. They contend that right of publicity protection endangers the freedoms granted under the First Amendment because it inevitably, and thus, unconstitutionally, restricts the methods by which parties can disseminate information.<sup>159</sup> However, upon further review of both case law and statutory provision regarding the right of publicity, any observer would readily recognize the overwhelming weakness, if not complete dearth, of such a legal argument. As discussed below, right of publicity case law – arguably broad at times – as well as statutory provisions do nothing more than try to avoid the creation of loopholes through which advertisers can misappropriate a person’s name or likeness, while simultaneously and explicitly upholding First Amendment guarantees.

The First Amendment of the United States Constitution states: “Congress shall make no law respecting establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press...”<sup>160</sup> Recognizing the vital attributes underlying the freedom of speech in any democracy, Justice Brandeis stated in his concurring opinion in Whitney v. California:

Those who won our independence believed that the final end of the State was to make men free to develop their faculties; and that in its government the deliberative forces should prevail over the arbitrary. They valued liberty both as

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<sup>158</sup> Henley, 46 F.Supp.2d 587, at 597.

<sup>159</sup> *See generally* White v. Samsung, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissent); *See generally* Wendt v. Host International, Inc., 197 F.3d 1284 (9th Cir. 1999) (Kozinski, J., dissent).

<sup>160</sup> *U.S. Const. amend. 1*.



an end and as a means. They believed liberty to be the secret of happiness and courage to be the secret of liberty. They believed that freedom to think as you will and to speak as you think are means indispensable to the discovery and spread of political truth; that without free speech and assembly discussion would be futile; that with them, discussion affords ordinarily adequate protection against the dissemination of noxious doctrine; that the greatest menace to freedom is an inert people; that public discussion is a political duty; and that this should be a fundamental principle to the American government.<sup>161</sup>

Providing some teeth to Justice Brandeis' lofty ideals, the California Supreme Court declared that the two main purposes of the First Amendment with regard to the freedom of speech: "First, to preserve an uninhibited marketplace of ideas' ...second, to foster a fundamental respect for individual development and self-realization."<sup>162</sup> In essence, based on subsequent case law, the latter's purpose is evoked to balance the "uninhibited" goal of the former. Whether in the realm of news or entertainment, courts have universally held that the marketplace of ideas can't operate with impunity, even in the face of the 1<sup>st</sup> Amendment.

In regards to newsgathering and dissemination, the 1<sup>st</sup> Amendment protects the press from liability when it publishes matters of public interest. The Supreme Court held that the "First Amendment provides an absolute defense to publication-based tort actions for publications on matters of public interest, unless the publications contain knowing or reckless falsehood."<sup>163</sup> Interpreting New York State statutory law regarding "public interest" and newsworthiness, the federal appellate court for the Southern District of New York held "New York courts have deemed as a matter of public interest not only news in

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<sup>161</sup> Whitney v. California, 274 U.S. 357, at 375 (1927).

<sup>162</sup> Guglielmi v. Spelling-Goldberg Prods., 25 Cal.3d 860, at 866 (1979).

<sup>163</sup> Schulyer M. Moore, Putting the Brakes on the Right of Publicity, 9 UCLA ENT. L. REV. 45, 49 (2001) quoting Gertz v. Robert Welch, Inc., 94 S.Ct. 2997, at 3008 (1974) (*defamation*) and Time, Inc. v. Hill, 87 S.Ct. 534 (1967) (public disclosure of private facts).

the sense of current events but also all types of factual, educational and historical data, or even entertainment and amusement...”<sup>164</sup>

This broad and liberal definition provides the news media substantial leeway under the 1<sup>st</sup> Amendment banner, even in the case of right of publicity actions. However, such protection is quelled in the context of commercial speech. Realizing the importance of the dissemination of information, state legislatures and courts have tried to craft a “remedy by balancing society’s high degree of entitlement in the area of informational uses against the type of harm being suffered by the plaintiff, the potential of consumer deception resulting from the defendant’s unauthorized use...and the potential for unjust enrichment.”<sup>165</sup> Consequently, most courts require the plaintiff to demonstrate, not only the authorized appropriation of their name or image, but that such misappropriation took place in a commercial context. For example, in Mendonsa, discussed previously, the court found that the sale of the pictures was commercial in nature, and therefore, upheld the plaintiff’s claim of “misappropriation of likeness. However, the court also stated that it “could not determine whether all other publications of the photograph that occurred subsequent to the original publication were commercial in nature.”<sup>166</sup> In essence, if the defendant had simply republished the picture in a newspaper, without the direct effort to profit off the picture itself, Mendonsa could probably not have demonstrated a prima facie case.<sup>167</sup>

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<sup>164</sup> Psyhoyos v. National Examiner, 1998 WL 336655, at 17-18 (S.D.N.Y. 1998). In Galella v. Onassis, 353 F. Supp. 196 (S.D.N.Y. 1972) the court held that the test for determining “newsworthiness” involved a balancing of factors such as: the social value of the fact published, the depth of the intrusion into exclusively private affairs, and the extent to which the party voluntarily assumed a position of public notoriety.

<sup>165</sup> Kwall, *supra* note 44, at 95..

<sup>166</sup> *Id.* at 94.

<sup>167</sup> *Id.*; See generally Tellado v. Time-Life Books, Inc., 643 F. Supp. 904 (D.N.J. 1986) wherein the defendant used the plaintiff’s picture, taken while he was serving in Vietnam, in various promotional

Requiring commercial use is equally important in light of Supreme Court precedent regarding First Amendment protection for commercial speech. As early as 1976, the Supreme Court recognized that wholly commercial speech is afforded some First Amendment protection. Two years later the Court noted that this protection is different than other forms of speech and is subject to more regulation. As noted by Roberta Kwall, one of the Court's concerns probably stemmed from the potential harm to society as a result of consumer deception.<sup>168</sup> With the groundwork in place, the Court decided the seminal case, Central Hudson Gas and Elect. Corp. v. Public Service Comm'n of New York, in which it promulgated a four-part test for determining the breadth of First Amendment protection for commercial speech.<sup>169</sup> The Court held that commercial speech can not be restricted unless the following elements are met: 1) The commercial speech must concern lawful activity that is neither false nor misleading; 2) The asserted governmental interest in restricting the speech must be substantial; 3) The restriction must directly advance the asserted governmental interest; and 4) The restriction must not be more extensive than necessary to serve that interest.<sup>170</sup> The Court concluded that speech proposing a commercial transaction is traditionally subject to

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materials for a series of books dealing with the Vietnam War. The photograph was not used in any of the books themselves but simply on the advertisements. The court held that the defendant could have used the photograph in the books while retaining 1<sup>st</sup> Amendment protection because such use would be considered newsworthy, regardless of the profit motive underlying the book. However, use of the photograph on the advertising material did constitute a breach of the plaintiff's right of publicity because these promotional materials were not considered newsworthy, and therefore afforded a much lower degree of protection under the 1<sup>st</sup> Amendment.

<sup>168</sup> See Kwall, *supra* note 44, at 66-69.

<sup>169</sup> Central Hudson Gas and Elect. Corp. v. Public Service Comm'n of New York, 447 U.S. 557, 566 (1980).

<sup>170</sup> *Id.*

governmental regulation, unlike those types of speech – news or purely informational – that normally garner absolute First Amendment protection.<sup>171</sup>

It is under this precept of commercial speech in relation to First Amendment protection that state statutes and court decisions have undertaken to establish right of publicity doctrine. And it is under this rubric in which they operate today, even in the face of growing skepticism and criticism over the broadening of common law “likeness” interpretations. It is also why this author unequivocally disagrees with scholars and judges who argue that right of publicity doctrine, particularly as a result of White, is spiraling out of control and heading towards a slippery slope that will inevitably create a severe, and perhaps irreversible conflict, with the First Amendment. The main reason for this respectful disagreement is the fact that precedent and statutory schemes have explicitly taken into account First Amendment guarantees and incorporated safeguards into their decisions and laws, respectively. It is precisely due to these safeguards that right of publicity plaintiffs MUST provide a high degree of evidence demonstrating commercial use of their name, image or likeness.

In addition, the plaintiff is required to adequately prove the unauthorized use of their indicia of identity. Some may argue that White clearly overstepped any bounds of rationality because it, in essence, gave the plaintiff an exclusive right over the commercial use of a blond-wigged robot in a game show setting.<sup>172</sup> Meanwhile, right of publicity advocates may counter by positing that evidence in the case demonstrated that consumers equated the robot with the plaintiff, as one in the same. Therefore, if the case came out the other way, it would simply provide advertisers with another tool, one now

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<sup>171</sup> See generally *id.*

<sup>172</sup> See generally White v. Samsung, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissent).

endorsed by courts, with which to create the perception of endorsement, regardless of its falsity.

Robots, notwithstanding of how life-like, could potentially replace the need to ever obtain a celebrity's consent. It is this author's opinion that such a potential loophole is exactly why right of publicity decisions hinge on the consumer perception of the use, because ultimately it is them who will suffer from such deceptive tactics. While the celebrity is forced to internalize the loss of value and public scorn over the false association, consumers will internalize the potential negative consequences on the back end by purchasing items under the misconception of a particular celebrity's endorsement. This author also contends that potential effects to consumers is also one of the policy reasons as to why courts and legislatures are not willing give advertisers, among others, carte blanche for commercial speech. Such restrictions are simply necessary in light of the market-driven consumer society, overwhelmed with manufacturing competition, in which much of the developed world lives.

### **Part III: Global Right of Publicity Protection**

Although much rhetoric continues to permeate legal discourse surrounding the need for a federal right of publicity, the pervasiveness of advertising, now on a global scale, serves the need to consider the availability of such protection in foreign lands. As P. John Kozyris noted, comparative law perspectives are "needed now more than ever because of the expansion of international transactions; the globalization of legal culture;

and the movements for unification, federation, and law reform around the world.”<sup>173</sup> This is even more important for U.S. celebrities whose names and likenesses have tremendous value worldwide.<sup>174</sup> “Many advertisements are internationally distributed. The internet is the ultimate borderless medium, incorporating both content and advertising.”<sup>175</sup> Consequently, an understanding of foreign publicity rights is all the more imperative to avoid substantial destruction to a celebrity’s value. To that end, in the first true sign of the need for global harmonization, the Loyola of Los Angeles Entertainment Law Journal hosted a symposium dedicated to international right of publicity schemes.

Please note that the decision regarding which countries to include within the following survey was based wholly on the availability of relevant matter rather than a subjective decision based on personal preferences. The reader should in no way interpret the exclusion of an Asian country from this section as a lack of interest, but simply the unfortunate result of an inability of obtaining information.

#### **A. United Kingdom**

Unlike the United States, the United Kingdom does not recognize a per se right of publicity, or any synonymous right to protect against commercial misappropriation of one’s name or likeness. For celebrities, the only course of redress, though limited, resides in either intellectual property law, in particular, copyright or trademark, as well as the tort of “passing off”. However, the English courts have narrowly construed publicity protection under these devices.

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<sup>173</sup> P. John Kozyris, Comparative Law for the Twenty-First Century : New Horizons and New Technologies, 69 TUL. L. REV. 165, 178 (1994).

<sup>174</sup> Dougherty, *supra* note 1, at 421.

<sup>175</sup> *Id.*

### **i. Copyright Law**

The Copyright, Designs and Patents Act of 1988 (“CDPA”)<sup>176</sup> is, theoretically, one avenue for protection against commercial misappropriation. Chapter 48 of the CDPA states that the copyright owner of an original artistic picture may prevent third parties from unauthorized reproduction or exploitation of such work.<sup>177</sup> Therefore, a celebrity acquiring copyright in an image has the right to prevent unauthorized commercial reproduction when a “substantial portion of the plaintiff’s work” has been appropriated.

However, this protection is only available with the picture itself, and not the subject underlying the image. The court in Re: Elvis Presley Trademarks, Inc., stated “[t]here is nothing akin to copyright in a name....Furthermore, an individual cannot obtain copyright in his own appearance.”<sup>178</sup> The court reasoned that if such a right existed, a celebrity could prevent a fan from tattooing the celebrity’s image on his person.<sup>179</sup> The court’s reluctance to entertain a claim for copyright in a name is in line with historical English case law. Since 1869, courts have refused to “recognize the absolute right of a person to a particular name...whatever cause of annoyance it may be.”<sup>180</sup> These judges were unwilling to differentiate, under copyright protection, between non-commercial, a tattoo, and commercial use of the name or likeness.<sup>181</sup>

Furthermore, the courts have only thinly granted the right of bona fide copyright holders, as under Chapter 48, to prevent the reproduction of an image. In Bauman v.

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<sup>176</sup> Copyright, Designs & Patents Act, 1988 (Eng.).

<sup>177</sup> *Id.* at ch. 48.

<sup>178</sup> Re: Elvis Presley Trademarks, Inc., 1997 R.P.D. & T.M. 543 (Ch.) (Eng.).

<sup>179</sup> Hayley Stallard, The Right of Publicity in the United Kingdom, 18 LOYOLA L.A. ENT. L.J. 565, 567 (1998).

<sup>180</sup> *Id.* (citing Du Boulay v. Du Boulay, 2 L.R.-P.C. (1896)).

<sup>181</sup> *Id.* (citing Re: Elvis Presley Trademarks, Inc., 1997 R.P.D. & T.M. 543).

Fussell, the court held that a painting incorporating the unauthorized reproduction of a “protected” photograph was not a Chapter 48 infringement because the artist had introduced personal creative vision into the painting and merely used the photograph as a reference.<sup>182</sup> Although some may argue that the defendant clearly used a “substantial portion” of the picture, in derogation of the CDPA, courts have defined “substantial portion” as an analysis of quantitative and, more importantly, qualitative measures. Not only how much of the work was appropriated, but whether that portion which the defendant recreated was the “feeling and artistic character” of the underlying work.<sup>183</sup>

## **ii. Trademark Law**

Under the Trade Marks Act of 1994, names, theoretically, receive protection, so long as they achieve the requisite level of distinctiveness.<sup>184</sup> Distinctiveness is attained when the name is: invented, not descriptive to the product’s characteristics, the applicant’s signature, or if the name is unique.<sup>185</sup> However, this protection is limited, if not altogether inapplicable, for celebrities. Although celebrities have attempted to protect their names under the Act, the relevant case law implies that “the more famous a personality becomes, as his or her name or nickname passes into common usage, the less likely it is that he or she will be entitled to claim an exclusive right to the name.”<sup>186</sup>

To illustrate this contention, the court in Re: Elvis Presley Trademarks, Inc., did not permit the plaintiff’s to register the name “Elvis Presley” because it was too well known to the public and, therefore, not distinctive.<sup>187</sup> In short, the more famous the

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<sup>182</sup> Bauman v. Fussell, 1978 R.P.D. & T.M. 485 (C.A.) (Eng.).

<sup>183</sup> Stallard, *supra* note 179, at 568; *See Ladbroke Ltd. v. Hill Ltd.*, 1 W.L.R. 273, 276-278 (Eng. H.L. 1964).

<sup>184</sup> Trade Marks Act, 1994, c. 26, § 1(d) (Eng.).

<sup>185</sup> Fisher, *supra* note 9, at 108.

<sup>186</sup> Stallard, *supra* note 179, at 569.

<sup>187</sup> Re: Elvis Presley Trademarks, Inc., 1997 R.P.D. & T.M. at 543.



celebrity the less likely he will have the right, because of a lack of distinctiveness, to register the name, and, thereafter, prevent its use in advertisements.<sup>188</sup> The court also surmised that the likelihood of confusion in having multiple manufacturers appropriate the image was both irrelevant and non-existent. “When people buy a toy of a well known character because it depicts that character, I have no reason to believe that they care one way or another who made sold or licensed it.”<sup>189</sup> It also appears that the court did not entertain an unjust enrichment argument, a cornerstone of United States Trademark protection, in rejecting the plaintiff’s registration petition.

In another likelihood of confusion action, the musical group ABBA sued for the unauthorized use of their images on T-shirts and pillowcases.<sup>190</sup> ABBA’s central argument was that the defendant was exploiting their image and that purchasers would incorrectly assume that the group had endorsed or were otherwise associated with these products.<sup>191</sup> The court vehemently disagreed with the plaintiff’s characterization of the purchasing public’s naivety, stating “I do not think anyone reading the advertisements...could reasonably imagine that all pop stars...were giving their approval for the goods offered.”<sup>192</sup> Since ABBA was in the music business and the defendant in the business of selling images, confusion either could not occur or that the public would not care if the, obviously illusory, endorsements were authentic.

It is clear that the English courts will not protect a celebrity’s name or likeness to the extent US court’s would, pursuant to a §43(a) action under the Lanham Act, because

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<sup>188</sup> Stallard, *supra* note 179, at 569.

<sup>189</sup> *Re: Elvis Presley Trademarks, Inc.*, 1997 R.P.D. & T.M. at 554.

<sup>190</sup> *Lyngstad v. Anabas Prod. Ltd.*, F.S.R. 62 (Eng. Ch. 1976).

<sup>191</sup> Fisher, *supra* note 9, at 108 (*citing Lyngstad v. Anabas Prod. Ltd.*, F.S.R. 62, 66).

<sup>192</sup> *Id.* at 67-68.

in their view likelihood of confusion will not ensue. In addition, since the names, themselves, are not distinctive, unjust enrichment is not a viable argument.

### **iii. Common Law Tort of Passing Off**

Although ABBA did not present a colorable claim of consumer confusion under the Trade Mark Act, an action under the common law tort of passing off could provide a similarly-situated celebrity a proper remedy. The tort of passing off, originating from acts of intentional deception, presumes to protect against consumer confusion and unjust enrichment, two justification courts were unwilling to entertain under the trademark cases. According to Hayley Stallard, “[w]here a personality is sufficiently well-known, the non-consensual use of his or her name, image, or voice may give rise to a misrepresentation that the personality endorses, of is connected with, the products or services in question.”<sup>193</sup> As Lord Langdale stated “a man is not to sell his own goods under the pretence that they are the goods of another man.”<sup>194</sup> This is so because the “property right protected is not that of the mark, the name, or the get-up itself, but the right in the goodwill attached to the business.”<sup>195</sup>

However, courts have constructed an overwhelmingly narrow window of protection, requiring that the plaintiff be actively engaged in the merchandising business in order to demonstrate a prima facie case.<sup>196</sup> The ABBA court reasoned that the group could not preclude the use of their name on t-shirts because they had never marketed such goods themselves. Therefore, they could not establish the requisite goodwill.<sup>197</sup>

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<sup>193</sup> Stallard, *supra* note 179, at 570.

<sup>194</sup> Julie King, The Protection of Personality Rights for Athletes and Entertainers Under English Intellectual Property Law: Practical Difficulties in Relying on an Action of Passing Off, 7 Sports Law J. 351, 353-354 (2000) (quoting Perry v. Truefit, 6 Beav. 66, at 73 (1842)).

<sup>195</sup> King, *supra* note 194, at 354.

<sup>196</sup> *Id.*

<sup>197</sup> Stallard, *supra* note 179, at 578.

In order to prevail, a plaintiff-celebrity would have to demonstrate that he had a reputation as an endorser, and that a significant portion of the public would mistakenly believe he endorsed the product. Even if the celebrity passes this hurdle, the courts have held that an “unofficial” disclaimer on the product was sufficient to prevent consumer confusion. Further complicating the matter is the fact that courts will only apply these principles to fictional characters and not real persons, who do not own the copyright in their name or likeness.

In Halliwell v. Panini SpA, the court was unwilling to grant an injunction to the “Spice Girls” in connection with a series of unauthorized stickers of the singers that did not include a disclaimer.<sup>198</sup> The court disagreed with the plaintiff that the lack of a disclaimer would confuse the public. It held that the “absence of the word ‘unofficial’ on the defendant’s product would not mislead the public.”<sup>199</sup> The court, synonymous with Elvis, held that the public placed very little, to no, significance on whether the endorsement was official relevance and that the “official” designation on the public’s purchasing decisions was minimal, at best.<sup>200</sup> Therefore, consumer confusion, a prerequisite to a passing off claim, did not exist.

#### **iv. Midler in the United Kingdom**

As is evident, the prospect of Bette Midler prevailing on a “right of publicity” claim in the United Kingdom is relatively weak. Based on the Elvis decision, and the English courts basic aversion to affording a celebrity intellectual property ownership in their name or likeness, the likelihood of a cause under either the CDPA or the Trade Mark Act seems far-fetched. First, under the CDPA Chapter 48, the court clearly held

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<sup>198</sup> Halliwell v. Panini SpA, 1997 LEXIS (Ch. June 6, 1997) (Eng.).

<sup>199</sup> Stallard, *supra* note 179, at 572.

<sup>200</sup> *Id.*

that no copyright resides in a name. Second, a court would probably find that Milder's name was not distinctive, as interpreted by case law, and, therefore, unprotected regardless of the commercial nature of a third party's use. Consequently, this author contends that, all things being equal, in the sense that Midler's popularity and goodwill are identical in the United Kingdom as they are in the United States, her best hopes for recovery reside in a "passing off" action.

In Reckitt & Coleman Products v. Borden, Inc., the House of Lords promulgated a three-part test to demonstrate a prima facie claim for passing off:

- 1) Plaintiff's reputation: Goodwill must be established in the mind of the public, or a reputation attached to the goods/services that he supplies by association with the identification of the packaging/get-up;
- 2) Defendant's representation: Establish misrepresentation by defendant to the public – intentionally or not – leading – or likely to lead – the public to believe defendant's goods are plaintiff's goods/services; and,
- 3) Likelihood of damage: Demonstrate that he suffers – or is likely to suffer – damage by reason of the erroneous belief caused by defendant's mis-representation.<sup>201</sup>

Based on Midler's career and persona, the singer could demonstrate that requisite goodwill in the minds of the public. As to the test's second prong, the Midler court held that the defendant made an intentional misrepresentation presumably leading to consumer confusion. However, as noted, English precedent takes an extremely narrow view of possible consumer confusion. Judge Oliver, in ABBA, simply did not believe that reasonable people would connect the plaintiff with the defendant's goods or services even in the face of unauthorized use of the plaintiff's name or likeness.<sup>202</sup> More recently, in the Spice Girls case, the court concluded that the public simply did not care about the

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<sup>201</sup> Reckitt & Coleman Products v. Borden, Inc., 1 W.L.R. 491 (1990).

<sup>202</sup> King, *supra* note 194, at 360.

product's origin. The public solely desired the product itself.<sup>203</sup> Unlike with U.S. right of publicity case law, not requiring proof of consumer confusion, Midler would have to show direct evidence of confusion. One option would be to compile consumer surveys demonstrating confusion over the product's endorsement and origin, akin to that used in trademark likelihood of confusion actions under §43(a) of the Lanham Act. Although case law has created a presumption against a finding of confusion, compelling survey results may overcome the ABBA-created prejudice.

Even if Midler established consumer confusion, her reluctance to enter the world of endorsements will probably create a complete bar to recovery. In order to prevail in a passing off action, Midler would have to prove that a common field of activity existed between Ford's use of her voice in advertisements and her personal initiatives in merchandising.<sup>204</sup> In ABBA, Judge Oliver refused to entertain the group's damage claim because they had never carried on any business in the UK beyond the production of music. Since ABBA had never entered the field of merchandising, not only would that preclude a finding of consumer confusion, but ABBA could not prove damages through the unauthorized use of their name.<sup>205</sup> As a result, if Midler had previously endorsed products, and, in particular, automobiles, she would probably have a better chance to prevail. However, her aversion to advertising, for whatever reason, may be her ultimate downfall. It is also interesting to note that English case law does not resolve, in regards to "common field of activity", whether Midler would simply have had to previously endorse any product or whether she had to have actually endorsed an automobile in order to prevail over Ford's use of her voice.

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<sup>203</sup> *Id.* at 366-367.

<sup>204</sup> *See generally Id.* at 360.

<sup>205</sup> *Id.*

The sheer lack of protection leaves celebrities with very few remedial options. Consequently, Julie King urges celebrities to follow certain guidelines to best protect their identity. She suggests:

Incorporate as a company as soon as possible with a registered trademark for the company logo and name...and signature of the individual, whether or not it is potentially problematic. Registration should be secured in classes that include common merchandising products such as textiles and stationary....Approach merchandising from an educational perspective...to inform the public of official merchandise....Take a number of photos in which the individual can own the copyright, and make them available as part of press kits that go along with the concept merchandising....Start immediately to trade in a wide variety of merchandise.<sup>206</sup>

Although good advice for celebrities who rely almost solely on their name and picture, it would not protect Midler, or other similarly-situated performers whose intrinsic value is derived from indicia beyond name or likeness. First, the English trademark system does not permit the registration of a person's voice. Even if Midler could register her voice as a trademark, Ford did not use her actual voice but accomplished the misappropriation through a sound a-like. Second, the English system forces performer's like Midler to merchandise products potentially undermining their personal values regarding commercialization. Consequently, notwithstanding Ms. King's recommendation, Midler would almost certainly not prevail in a publicity rights action under English law.

## **B. France**

Translated as *la droit a l'image*, the right of image in France is muddled in ambiguity, particularly, in relation to the protection against unauthorized *commercial* use

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<sup>206</sup> King, *supra* note 194, at 372-373.

of one's name or image.<sup>207</sup> The right, derived from the general tort under Article 1382 of the Civil Code, is mired in controversy as to whether it is a property right, akin to the United States right of publicity, and, therefore applicable against commercial misappropriation, or whether the right solely provides a personal privacy protection. If it's the latter, it would only protect against the morally-based repercussions – reputation and embarrassment – associated with unauthorized use of a name or likeness.<sup>208</sup>

### **i. Droit a L'image**

Article 1382 of the Civil Code states, quite broadly and ambiguously, that: Any person who performs an act that harms another person must compensate the other for the harm caused by that act.<sup>209</sup> Out of this Article judicial precedent extrapolated a right of image, recognized as a bundle of personality rights, including the right to prevent the unauthorized fixation and reproduction of one's image.<sup>210</sup> Although a slight shift in the courts have occurred, this personality protection consisted mostly of moral rights: "the right to privacy, the right to protect one's honor and reputation, and the right to control the use of one's image."<sup>211</sup> It is only recently, and narrowly, that French courts are entertaining a commercial misappropriation claim under this right of image bundle.

The moral rights underlying the right of image was first recognized by French courts in the late 19<sup>th</sup> century in a case commonly referred to as the Rachel Affair.<sup>212</sup> In the Rachel Affair, an artist drew a portrait of the famous actress Rachel on her deathbed, and, thereafter, proceeded to sell the work. Understandably, the deceased's family

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<sup>207</sup> Elisabeth Logeais & Jean-Baptiste Schroeder, The French Right of Image: An Ambiguous Concept Protecting the Human Persona, 18 LOYOLA L.A. ENT. L.J. 511 (1998).

<sup>208</sup> Dougherty, *supra* note 1, at 435.

<sup>209</sup> Code civil [C. civ.] art. 1382 (Fr.); see Logeais, *supra* note 173, at 514.

<sup>210</sup> See Logeais, *supra* note 207, at 513.

<sup>211</sup> *Id.* (citing Jeanne M. Hauch, Protecting Private Facts in France: The Warren & Brandeis Tort is Alive and Well and Flourishing in Paris, 68 TUL. L. REV. 1219, 1228 (1994)).

<sup>212</sup> T.P.I. Seine, June 16, 1858, 52 [hereinafter the "Rachel Affair"].

vehemently objected to the sale and initiated a right of privacy, not a right of image, action.<sup>213</sup> The court, siding with the family, held “[n]o one may, without the explicit consent of the family, reproduce and bring to the public eye the image of an individual on her deathbed whatever the celebrity of the person involved.”<sup>214</sup> The court found the basis for its decision under the moral right of respect for the family’s suffering.

Since the Rachel Affair, French courts have broadened the scope of protection and established a right of image independent from actions regarding invasion into someone’s private life. For example, in the Papillon decision, the court held that the plaintiff had the right to prohibit the unauthorized use of his photograph on the front cover of a book detailing his life.<sup>215</sup> The court held that the book itself was not an invasion of privacy. However, the use of the photograph, without the plaintiff’s consent, infringed his right of image.<sup>216</sup>

In light of Papillon, French courts have begun to face the dilemma characterized as the conflicting concepts between a right *to* one’s image versus a right *on* one’s image. Right of image experts Elisabeth Logeais and Jean-Baptiste Schroeder explain that understanding the difference between privacy and property arguments for protection of one’s image is key:

On the one hand, the right *to* protect one’s image from unwanted exposure embodies a privacy interest. This aspect flows from the general difficulty in placing a specific value on one’s personal rights, while also recognizing the general consensus that one cannot alienate a personal attribute – the extra patrimonial nature of the right....On the other hand, the right also embodies the

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<sup>213</sup> Logeais, *supra* note 207, at 514.

<sup>214</sup> *Id.* (citing T.P.I. Seine, June 16, 1858, 52 as translated by Hauch, *supra* note 177, at 1233).

<sup>215</sup> T.G.I. Paris, ord. ref., Feb. 27, 1970, JCP 1970, II, 16293 [hereinafter the “Pappilon Case”].

<sup>216</sup> *Id.*; See Logeais, *supra* note 207, at 515. It is also interesting to note the similarities in the court’s decision on bifurcating the picture’s uses, with the US court’s holding in Tellado v. Time-Life Books, Inc., 643 F.Supp. 904 (D.N.J. 1986), *supra* note 134 and accompanying text.



desire to protect a marketable asset...characterized as the right *on* the image (or the right to profit on the image) – the patrimonial nature.<sup>217</sup> (emphasis added)

The Paris Court of Appeals, recognizing this problematic distinction, held that a violation of the right of image may cause both economic and moral injury when a celebrity had attained commercial value to his image.<sup>218</sup> Consequently, “the modern perception of the right of image recognizes its dual nature, encompassing both a negative, subjective right to prohibit fixation and reproduction of one’s image, as well as a positive, economic right to commercially exploit one’s image.”<sup>219</sup> It is important to note that “image”, in France, includes likeness, voice, photograph, portrait, or video reproduction.

Right of image case law has explicitly stated that any person, regardless of fame, can prevent the misappropriation of their image. As Logeais and Schroeder discuss, judicial precedent has established four principles regarding the right to one’s image. First, the medium used to reproduce the person’s image is irrelevant. Second, a celebrity’s stage name is also protected, even if fictitious, because the name is representative of their personality. Third, the person must remain recognizable in the reproduction. The less famous the person in the image, the more conspicuous his image must be in the reproduction. Finally, courts have strongly affirmed the concept that “[c]onsent must be clearly expressed for both the taking and the further usage of the person’s image.”<sup>220</sup>

These principles have broadened the scope of protection courts will entertain to include, though narrowly, claims against commercial misappropriation of a celebrity’s property value in their image. In Noah v. Soc. Frse de Revues Team, the court upheld the

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<sup>217</sup> Logeais, *supra* note 207, at 517.

<sup>218</sup> *Id.* (citing CA Paris, Sept. 10, 1996, R.D.P.I., n. 68, 63 [Les Editions du Sand & Pasquito v. Kantor])

<sup>219</sup> Logeais, *supra* note 207, at 517-518.

<sup>220</sup> Logeais, *supra* note 207, at 519-521.

right of the plaintiff, Yannick Noah, a famous tennis player, to prevent the unauthorized reproduction of his photograph in brochures lacking any informative captions.<sup>221</sup> The court found that the brochure was purely commercial and, therefore, dismissed the defendant's newsworthy argument.<sup>222</sup>

Interestingly, French courts have also bifurcated their analysis as to the type of injury suffered, both directly on the celebrity and the potential injury caused by consumer confusion. In Belmondo, Halliday and Vartan v. Eminence, the defendant's posters portrayed impersonators of the plaintiff-singers.<sup>223</sup> The court awarded damages because consumers were shown to have believed that the singers had endorsed the product. However, since the singers had never marketed their image, the court held that awarding damages for direct economic injury to the plaintiff's value were inappropriate because the plaintiffs could not demonstrate a loss of profits.<sup>224</sup> In relation to Midler, the court's willingness to recognize the ensuing consumer confusion due to the use of an imitator as the basis for recovery is vital to a successful claim.

## **ii. Midler in France**

Based on Logeais and Schroeder's extrapolated principles, as well as the French court's recent propensity for protecting the right *to* one's image, Midler could prevail in a claim against Ford. Under French law, the two relevant prongs regarding Midler pertain to: 1) whether Midler was recognizable in the reproduction of her "image", and 2) the lack of consent.

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<sup>221</sup> Noah v. Soc. Frse de Revues Team, T.G.I. Paris, Dec. 21, 1983, D. 1984, Somm. 331.

<sup>222</sup> Logeais, *supra* note 207, at fn 102.

<sup>223</sup> Belmondo, Halliday and Vartan v. Eminence, T.G.I. Paris, 3e ch., Feb. 24, 1976, available in Francois Greffe, *La Publicite et la Loi* (Publicity and Law) 214 (1994).

<sup>224</sup> Logeais, *supra* note 207, at fn 46.

As in Belmondo, French courts will entertain claims of misappropriation where the advertisers employed the services of imitators to copy a celebrity's highly distinguished traits. As early as 1975, a French court held that "the imitation of the actor's voice infringed his personality rights and such wrongdoing entailed moral and professional damage."<sup>225</sup> Consequently, if Midler can properly demonstrate that consumers mistakenly believed the voice in the commercial was hers, as she did in the United States, the use of an imitator will not prevent a finding of infringement.

Many consider the "consent" requirement the key element in determining the breadth of permission to use one's image. The use of a person's image requires prior, express, and specific consent given for a specific use and duration. Furthermore, the toleration of past uses does not constitute a general waiver to persistent future appropriation.<sup>226</sup> For Midler, the fact that she explicitly forbade Ford to use her voice in their advertisements will work greatly to her advantage.

Although Midler is likely to prevail in a case against Ford, the court will probably diminish the extent of damages because of her persistent refusal to market herself beyond her professional career. She could receive damages as a result of the consumer confusion, but a court will not award her economic damages, in line with Belmondo, because she had never marketed herself in the past. Therefore, a court might decide that she could not prove lost profits to her merchandising enterprise. However, such a holding would ignore the potential of future lost profits both in merchandising, as well as in her acting career. For example, if the advertisement was dishonorable to Midler's reputation, the market value of her image could plummet.

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<sup>225</sup> Pieplu v. Regie Francaise de Publicite, T.G.I. Paris, Dec. 3, 1975, D. 1977-211; Logeais, *supra* note 173, at fn 47.

<sup>226</sup> See Logeais, *supra* note 207, at 521-522, 524-525.

As discussed, Midler was forced to internalize the externalities of Ford's actions. In order to avoid such a consequence, a court may be better off disregarding past merchandising, or lack thereof, as the sole indicator of lost profits and entertain evidence of future economic loss. This would produce two positive and equitable results. First, it would economically redress the injury to the plaintiff's intrinsic value. Second, it would further deter advertisers from engaging in deceptive merchandising because it would close the remedial loop-hole requiring a demonstration of direct and contemporary lost profits.

### **C. Italy**

Like many countries, Italy's legal framework does not expressly provide right of publicity protection. However, an individual is not without protection, as courts have recently concluded that several sections of the Italian Civil Code, modeled after the French Code Civil, protect the "right to image" as that of a personality right.<sup>227</sup>

Particularly, an individual can seek redress through several statutory enactments centered on an individual's privacy, protection of one's image or name, and copyright law.

However, as this section will discuss, the greatest degree of protection may lie outside the bounds of legislative language, and with the court's judicially recreated right, which in some respects mirrors the amorphous language in White.

#### **i. Statutory Law**

The Italian Civil Code incorporates several articles under which a private individual can seek protection from the unauthorized use of his name or image. In

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<sup>227</sup> See Dougherty, *supra* note 1, at 435; Silvio Martuccelli, Symposium International Rights of Publicity: The Right of Publicity Under Italian Civil Law, 18 LOYOLA L.A. ENT. L.J. 543, 544-546 (1998).

particular, Articles 6 and 7 protect the right to one name, while Article 10 is directed at a person's image.

While Article 6 expressly states the overall premise that “every person has a right to the name given [him or her] according to law”, Article 7 articulates the potential for judicial intervention.<sup>228</sup> The article states: A person whose right to the use of his name is contested or who may be prejudiced by the use made of it by others, can judicially request that the injurious practice be terminated, without prejudice to the right to recover damages.<sup>229</sup> Meanwhile, Article 10 provides the ability to prohibit the use of one's image with prior consent. It states:

Whenever the likeness of a person...has been exhibited or published in cases other than those in which such exhibition or publication is permitted by law, or in a manner prejudicial to the dignity or reputation of such person or relative, the court...can order the termination of such abuse without prejudice to the right to damages.<sup>230</sup>

Interestingly, the ending language of both Article 7 and 10 explicitly notes that the issuance of injunctive relief, in terminating the unauthorized use of one's name or image, will not affect the potential for recovery of damages of such use. Although the language of these Articles arguably provides a plausible avenue of redress, in reality the statutes are right of privacy centered, and therefore, may bar recovery to celebrities who solely claim financial injury.<sup>231</sup>

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<sup>228</sup> Silvio Martuccelli, Symposium International Rights of Publicity: The Right of Publicity Under Italian Civil Law, 18 LOYOLA L.A. ENT. L.J. 543, 546 (1998) *citing* C.c. (Delle Persone e della famiglia) [Persons and the Family] arts. 6 and 7, translated in 1 Italian Civil Code and Contemporary Legislation bk. 3, tit. I, arts. 6 and 7.

<sup>229</sup> Martuccelli, *supra* note 228, at 546-547.

<sup>230</sup> *Id. citing* C.c. (Delle Persone e della famiglia) [Persons and the Family] art 10, translated in 1 Italian Civil Code and Contemporary Legislation bk. 3, tit. I, art. 10

<sup>231</sup> See Guido Alpa, The Protection of Privacy in Italian Law: Case Law in a Codified Legal System, 12 TUL. EUR. & CIV. L.F. 1, at \*4-5 (1997)

Finally, a person can seek right of publicity redress under Article 96 of the 1941 Copyright Law that prohibits the unauthorized display, reproduction or commercial distribution of a person's portrait.<sup>232</sup> However, akin to the First Amendment argument fervent with right of publicity naysayer in the United States, Italy's Copyright Law includes freedom of speech protective language in that Article 96 does not extend to "justified" uses including "when reproduction is associated with facts, events and ceremonies which are of public interest or have taken place in public."<sup>233</sup> Such use by police or for scientific, didactic, or cultural reasons is also protected against publicity claims.

## **ii. Common Law**

Although the Italian Civil Code, as well as the Copyright Law provides explicit protection against the unauthorized use of one's name or image, the strongest degree of protection may lie with the judicially created right of publicity. Unlike English case law that further hindered the ability of an individual to obtain a proper remedy, creating, arguably, insurmountable obstacles to successful litigation, Italian courts have expanded the right of publicity protection concurrently available under the Civil Code. As a result, individuals enjoy broad protection against the unauthorized use of their indicia of identity, which, in some ways, mirrors the broad language of the Ninth Circuit.

The seminal case, first recognizing the right of publicity, beyond the bounds of the Italian Civil Code, involved Lucio Dalla, a famous Italian singer. Dalla brought an action against Autovox SpA, and alleged that the company misappropriated his persona in using two of his most distinctive elements, a woolen cap and a pair of small round

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<sup>232</sup> See Martuccelli, *supra* note 228, at 547.

<sup>233</sup> *Id.*

glasses, in an advertising poster.<sup>234</sup> Eerily similar to White and Midler, Dalla argued that the defendant misappropriated his persona in that consumers would immediately associate the cap and glasses with him, and, consequently, would mistakenly believe that he endorsed the products depicted in the poster. Like Tom Waits, Dalla had always refused to endorse products.<sup>235</sup>

As Silvio Martuccelli notes, the court's power if not expectation, to "reason by analogy" between the Civil Code and a controversy to which no applicable law existed, laid the foundation for Dalla's successful action. Applying the principles of Article 10, "the judge in the Dalla case reasoned that such protection should also apply to unauthorized uses of attribution of one's persona."<sup>236</sup> The court concluded that "Dalla's right of image had been infringed not by the publication of his picture or portrait, but by the reproduction of some distinctive elements of his personality..."<sup>237</sup> Ever mindful of "freedom of speech" counter-arguments, the judge recognized that the use of Dalla's indicia of identity was purely for commercial purposes, not for purposes of public interest in information.<sup>238</sup>

Following Dalla, courts not only embraced the holding but have arguably broadened it by awarding protection for "the mere fame or popularity of the celebrity".<sup>239</sup> Two years after Dalla, the Italian court in Bablioni v. Eretel Srl and Disco Spring held that the unauthorized use the plaintiff's image and signature in a calendar constituted a

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<sup>234</sup> Martuccelli, *supra* note 228, at 549 *citing* Pret. Di Roma, 18 apr. 1984, Foro It. 1984, I, 2030 (with comment of Pardoesi; Guir. It. 1985, I, 2, 453 (with comment of Dogliotti, questioni in tema di notorieta, diritto all'immagine e tutela della personalita [Some Issues about Notoriety, Right of Image and Protection of Personality]).

<sup>235</sup> Martuccelli, *supra* note 228, at 549.

<sup>236</sup> *Id.* at 549-550.

<sup>237</sup> *Id.* at 550.

<sup>238</sup> *See id.* at 550-551.

<sup>239</sup> *See id.* at 551-552.

right of publicity infringement.<sup>240</sup> Thereafter, the court held that the use of a look-a-like of a famous actress – Monica Vitti – in a magazine advertisement misappropriated her persona, in large part, because of the uses commercial nature.<sup>241</sup> Akin to the Ninth Circuit’s reasoning in *Midler*, the use of an imitator will not prevent a right of publicity action, so long as the sufficient indicia of identity of the celebrity are evoked.<sup>242</sup>

As Martucelli synthesizes, Italian courts have justified this broad right of publicity on three grounds: 1) protecting “an individual’s interest in personal dignity and autonomy”; 2) preventing unjust enrichment by protecting the celebrity’s commercial value, and; 3) indirectly protecting consumer against “false suggestions of endorsement”. Although these justifications mirror those typically put forth in the United States, the Italian system does require one major difference – celebrity status.<sup>243</sup>

### **iii. Midler in Italy**

Unlike the United Kingdom and France, where *Midler* may have significant problems bringing a successful “right of publicity” action, her chances in Italy are extremely strong. First, instead of a purely privacy-based scheme, which may preclude recovery, Italy has fully recognized a celebrity’s right to the commercial value of their image. Second, as the court clearly laid out in *Vitti*, the use of an impersonator is no defense to liability. Third, *Midler*’s unwillingness to inject herself into the world of endorsements is not a bar to recovery and, in actuality, may work to her advantage in arguing that the replication of her voice damaged her reputation. Finally, and certainly most important to a successful action, Martucelli notes that “Italian civil law recognizes

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<sup>240</sup> See *id.* at 552 citing Pret. di Roma, 18 feb. 1986, *Il diritto di autore* 1986 215.

<sup>241</sup> See *id.* at 552-553 citing Pret. di Roma, 6 july 1987, *Il diritto di autore* 1987, 570.

<sup>242</sup> See *id.*

<sup>243</sup> See *id.* at 555-556.



that foreigners have the right to initiate any legal proceedings available to Italian citizens to protect the enjoyment and the exploitation of one's rights."<sup>244</sup>

#### **D. Argentina**

In Argentina, like the laws of the United Kingdom, no express positive law creates a right of publicity. Protection for the concept of *derechos personalísimos*, or highly personal rights, is derived, if at all, from legal principles existing under different bodies of Argentine law. With an absence of a direct personality rights statute, plaintiffs must turn to other bodies of law, including: International Law, Intellectual Property law, and the Right to Intimacy and Privacy.<sup>245</sup>

##### **i. International Law**

In accordance with the Argentine Constitution, international agreements are given constitutional status making them, in effect, directly applicable into law. Particularly, the Universal Human Rights Declaration ("UHRD") provides that every human is entitled to recognition of one's legal personality.<sup>246</sup> Furthermore, the American Declaration on Human Rights and Duties of Man ("ADHR") provides protection against attacks on a person's reputation and private life.<sup>247</sup> Additionally, Article 19 of the Constitution specifically protects a person's right to privacy.<sup>248</sup>

Two main problems exist when relying on these international laws for a right of publicity claim alleging the unauthorized commercial use of a celebrity's name or

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<sup>244</sup> *Id.* at 561.

<sup>245</sup> See Guillermo Cabanellas, The Right of Publicity under Argentine Law, 18 LOYOLA L.A. ENT. L.J. 449, 450 (1998).

<sup>246</sup> Universal Declaration of Human Rights, Dec. 10, 1948, G.A. Res. 217 A(III), U.N. Doc. A-810 (1948), reprinted in 5 Marjorie Whiteman, Digest of International Law 237-242 (1965).

<sup>247</sup> American Declaration on Human Rights and Duties of Man, May 2, 1948, O.A.S. Res. XXX, reprinted in Organization of American States, Basic Documents Pertaining to Human Rights in the Inter-American System, 18 OEA/Ser. L.V./ II. 82 doc. 6 rev. 1 (1992).

<sup>248</sup> Const. Arg. art. 19.

likeness. First, they do not create any specific and redressable claims but simply put forth general notions and directives. It is up to the signatory State to promulgate legal doctrine in accordance with the agreements themselves. Therefore, a celebrity will still need to investigate laws in other sections of the Argentine Legal Code.

Second, the agreements do not appear to address misappropriation of one's likeness under the rubric of a property right, but only as relating to the right of privacy. As a result, the agreements, in themselves, may not provide sufficient protection, if any, for celebrities whose claims are normally based on a theory of commercial misappropriation and lack of adequate compensation for the use of the image, and not for the reputation-based arguments common with privacy rights.

## **ii. Intellectual Property Law**

In discussing the right of publicity in Argentina, one must consider possible protection under both copyright and trademark law. Unlike the United States, Argentine copyright laws specifically provide protection for publicity rights. Meanwhile, trademark protection could safeguard certain, but not all, aspects of a celebrity's persona.

Article 31 of the Copyright Law provides that a person's photograph may not be used in commerce absent the express consent of that person.<sup>249</sup> Synonymous with French laws, consent for a specific use may not be extended to other uses, regardless of past toleration.<sup>250</sup> Furthermore, the statutes' protection applies to the use of a person's image and voice in a variety of mediums. Although the limits of protection are ambiguous, many argue that only commercial misappropriations are redressable. Several non-

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<sup>249</sup> Law No. 11723, art. 32, Sept. 28, 1933 [1920-1940] A.D.L.A. 450.

<sup>250</sup> Cabanellas, *supra* note 245, at 454.

commercial uses – educational, newsworthy, scientific and cultural – are explicitly exempt.<sup>251</sup>

In order to bring a right of publicity claim under the Copyright Law, a claimant has to demonstrate, akin to the United States, that an “unauthorized use of a person’s image or other elements of a person’s identity by means of reproducing the image or elements....the plaintiff is not required to show malice, loss of business or clients, defamation, harassment, or the invasion of privacy. Tortious conduct results from the mere reproduction of a person’s identity...”<sup>252</sup> As mentioned, specific non-commercial uses are the only exceptions.

Argentine Trademark Law would also offer right of publicity protection, though solely to a limited set of features. Specifically, Article 3(h) of the Trademark Law protects against the unauthorized use of a person’s name or portrait as a trademark.<sup>253</sup> According to Guillermo Cabanellas, Argentine trademark law will protect a person’s publicity right in two aspects. First, if a person registers or uses an aspect of their identity as a trademark, he is granted an exclusive property right to that trademark. This protection extends to “aspects such as a person’s name, photograph, picture, or likeness.”<sup>254</sup> Second, “the elements of a person’s identity may not be used or registered as a trademark without such person’s authorization...”<sup>255</sup> If a third party wants to use or register as a trademark an aspect of a person’s identity – names, pseudonyms and portraits – under Article 3(h), that party will need express consent.<sup>256</sup>

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<sup>251</sup> *Id.* at 454-455.

<sup>252</sup> *Id.* at 463

<sup>253</sup> Law No. 22362, art. 3(h), Dec. 26, 1980, [1981-A] A.J.L.A. 8.

<sup>254</sup> Cabanellas, *supra* note 245t 455.

<sup>255</sup> *Id.*

<sup>256</sup> *Id.*

Therefore, one can argue that Argentine trademark law provides both a sword and shield against commercial misappropriation. As to the former, the law grants an exclusive property right that can be employed to prevent unauthorized use. The law also provides a shield in requiring consent prior to the use or registration of a person's identifying features.

### **iii. Right to Intimacy and Privacy**

Pursuant to Article 1071-bis of the Civil Code, certain unauthorized uses of a person's name, likeness, voice or photograph may constitute a tort for the violation of the right of intimacy.<sup>257</sup> Article 1071-bis provides that "any person who arbitrarily intrudes into another person's life, publishes portraits...mortifies another person with regard to one's habits or feelings, or otherwise damages his or her intimacy" shall be liable for damages.<sup>258</sup> Although purportedly a right of publicity statute, Article 1071-bis' language, as well as relevant case law strikes a strong similarity to a right of privacy doctrine because of its focus against moral and emotional injury instead of commercial harm.

In Ponzetti de Balbin v. Editorial Atlandia, a newspaper published the picture of a prominent politician on his deathbed.<sup>259</sup> In an Article 1071-bis action brought by the deceased's family, the court found the paper's actions reprehensible as an infringement of the family's privacy expectations.<sup>260</sup> Other cases have held as infringing both the creation of a false or harmful impression on a person's acquaintances,<sup>261</sup> and the placing

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<sup>257</sup> Cod. Civ. art. 1071-bis.

<sup>258</sup> Cabanellas, *supra* note 245, at 458 (citing Cod. Civ. art. 1071-bis.)

<sup>259</sup> Ponzetti de Balbin v. Editorial Atlandia, CSJN, [1985-B] L.L. 114.

<sup>260</sup> Cabanellas, *supra* note 245, at 458.

<sup>261</sup> *Id.* citing Mosset Iturraspe, Broma, Chanza o Burla Mortificante, [1981-D] L.L. 447.

of a person's image in a ridiculous setting.<sup>262</sup> Furthermore, relevant precedent has redressed any damage to a person's reputation, prestige, or feelings.

#### **iv. Midler in Argentina**

Midler could approach a suit under Argentine Law vis-à-vis any of the approaches described above. However, the privacy mantra under which the Argentine Constitution, coupled with the UHRD and ADHR, as well as Article 1071-bis apply will make her case very difficult to properly demonstrate if based wholly on a theory of loss to commercial value.

Midler's best chance of recovery for a direct right of publicity action is pursuant to Argentina's, unusually, broad copyright laws. Article 31 prohibits the use of a person's name, image or likeness for commercial purposes without their express consent. Furthermore, experts have posited that "image" would include the use of a person's voice without authority. Of course Midler's main hurdle relates to the fact that Ford did not actually use her voice in the advertisement. Research for this article did not reveal any precedent dealing directly with the issue voice imitation as violative of Article 31.

Midler could pursue an Article 1071-bis action if she manages to surpass several hurdles. First, and foremost, she will need to demonstrate that Ford's misappropriation caused harm, not to her commercial value, but to her reputation and honor as a person who, for artistic or personal reasons, refrained from engaging in merchandising. Her persistent refusal to endorse products, notwithstanding her undeniable goodwill, would help her cause. Second, Midler will need to prove that an imitated voice is an attribute incorporated within Article 1071-bis. She could present evidence of consumer confusion

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<sup>262</sup> *Id. citing* Bidart Campos, Una Condena al Sensacionalismo Periodístico por Agraviar la Privacidad de Una Persona, 136 E.D. 236 n.3 (1990).

to argue that using an imitator is irrelevant because consumers believed it was her, due in large part to her celebrity status and highly recognizable voice, and, therefore, she suffered an injury identical to one suffered via the use of her actual voice.

Under either theory, she could argue that public policy favors protection against unauthorized voice imitation. If such protection is not granted, the courts would have created an incredible loophole for advertisers which would lead to severe economical and emotional harms. Aside from voice misappropriation, such precedent would permit advertisers, with impunity, the right to use third parties to imitate any of the personal attributes of a celebrity without consent or remuneration.

## **E. Brazil**

Like its South American neighbor, Brazil protects right of publicity-like interests under several bodies of law.<sup>263</sup> Though not labeled as right of publicity statutes, the Brazilian Constitution and neighboring rights, as well as Consumer Laws can provide some forms of protection under the umbrella of personal rights which provide exclusive rights to image and privacy.

### **i. Brazilian Constitution**

Article 5, Section X of the 1988 Brazilian Constitution regulates the right to privacy, as well as the right to a person's image. Section X states that "privacy, private life, honor, and the image of all people are inviolable. It also "assures the right to compensation for material and moral harms resulting from violating one's rights."<sup>264</sup>

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<sup>263</sup> Dougherty, *supra* note 1, at 436.

<sup>264</sup> Deborah Fisch Nigri & Silvia Regina Dain Gandelman, The Right of Publicity in the Brazilian Legal System, 18 LOYOLA L.A. ENT. L.J. 469 (1998) (*citing* Constituico Federal [Federal Constitution] [C.F.] art. 5, X (1988) (Braz.).

The Section's broad language – material and moral harms - protects against any unauthorized use. In addition, no formalities are required before a plaintiff can invoke Section X.<sup>265</sup> Unlike the privacy-esque laws prevalent in other States, protecting only against emotional and reputational injury, Brazil's Constitution clearly protects injuries related directly to the economic loss associated with the unauthorized use of a celebrity's image. The “sole prima facie element for violation of the right is lack of consent.”<sup>266</sup>

According to Deborah Fisch Nigri and Silvia Regina Dain Gandelman, Samuel Warren and Louis Brandeis' right of privacy article had a profound impact on the development of Brazil's privacy and image rights laws.<sup>267</sup> In addition, Brazilian lawmakers and courts remain concerned that without effective laws, modern technology would further afford advertisers tools to invade a person's privacy.<sup>268</sup> As a result of this explicit legislative intent, the courts have construed Section X's language broadly and, arguably, with a pro-plaintiff tendency.

In Maite Proenca Gallo v. Editora Azul,<sup>269</sup> the magazine-defendant published photographs of a famous actress during a play in which she appeared nude. The audience was asked to refrain from taking pictures. In a suit alleging material and moral injury for the unauthorized use of the picture, the court found for the plaintiff notwithstanding the fact that the picture was reproduced in a newspaper.<sup>270</sup>

In addition to the Gallo decision, protecting unauthorized exploitation of image through a photograph, Section X protection is not limited to an exclusive number of

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<sup>265</sup> Nigri & Gandelman, *supra* note 264, at 474.

<sup>266</sup> *Id.*

<sup>267</sup> *Id.* at 471.

<sup>268</sup> *Id.* at 472.

<sup>269</sup> Maite Proenca Gallo v. Editora Azul, STJ, RE 19.151-RJ No. 92004399-2, Relator: Athos Cameiro, 17.11.1992, D.A. 17.12.92, p. 100.

<sup>270</sup> Nigri & Gandelman, *supra* note 264, at 473.

mediums but is malleable with advances in technology.<sup>271</sup> Furthermore, the Constitution also explicitly protects against the unauthorized use of images and voices of athletes and sports celebrities. Article 5, Section XXVIII(a) states “[i]t is assured under the law protection to individual performances of collective works and the reproduction of image and human voices...”<sup>272</sup> Although the Constitution does not explicitly provide a remedy for the commercial misappropriation of a celebrity’s image through the use of an imitator, it is easy to assume that a court could extend these Constitutional provisions to entertain such a claim.

Brazil has also recognized the doctrine of neighboring rights as a bona fide avenue, used in conjunction with Constitutional provisions and copyright laws, to protect a person’s right of publicity. Neighboring rights protect “modes of expression” not explicitly covered in the copyright laws.<sup>273</sup> Akin to U.S. copyright laws, Brazilian authors and photographers have the exclusive right to prevent the unauthorized reproduction of their work.<sup>274</sup> Therefore, the government’s recognition and endorsement of such rights further supports the idea that a celebrity could garner protection against the unauthorized commercial use of her voice, even by way of imitation. As Nigri and Gandelman note “[d]espite the pervasiveness of voices and images in our daily life...protection of personal attributes of the persons engaged in these activities has been historically considered less worthy of traditional copyright protection than that afforded to authors of books and creators of works of art.”<sup>275</sup> It appears that the indoctrination of neighboring rights, as ancillary to other legal protection measures, demonstrates the

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<sup>271</sup> See *id.* at 473-474.

<sup>272</sup> C.F. art. 5, XXVIII(a).

<sup>273</sup> Nigri & Gandelman, *supra* note 264, at 476-477.

<sup>274</sup> *Id.*

<sup>275</sup> *Id.* at 476.



government's willingness to extend personality rights beyond the copyright and Constitutional frameworks.

## **ii. Consumer Laws and Advertising Regulations**

Another avenue of protection for right of publicity plaintiffs exist under Brazilian Consumer Laws, as well as regulations directed toward the advertising industry. Known as the Brazil Self Regulatory Publicity Code, the *Codigo Brasileiro de Auto-Regulamentac o Publicitaria* ("CBAP")<sup>276</sup> is administered under the auspices of the *Conselho Nacional de Auto-Regulmentac o Publicitaria* ("CONAR"). In one of the more progressive regulatory schemes, these regulations "secure a certain level of protection between the advertising agency and its client, and between the agency and the consumer."<sup>277</sup>

Article 37 under the Consumer Laws forbids any kind of misleading or abusive advertisement and states, in relevant part, that:

Section 1: Any kind of public advertisement, totally or partially false, or by any means, even by omission, capable of inducing the consumer in error with regard to the nature, characteristics, quality, source, price, or any other information regarding products and services, is considered misleading;  
Section 3: For the purpose of this Code publicity is misleading by omission whenever it fails to present essential information regarding the product or service.<sup>278</sup>

Violation of these statutes could lead to the levying of penal and monetary fines on anyone, agency and advertiser, who disseminates misleading or abusive publicity which could potentially lead to consumer confusion.<sup>279</sup>

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<sup>276</sup> *Codigo Brasileiro de Auto-Regulamentac o Publicitaria*, [CBAP], ch. 1, 1980.

<sup>277</sup> Nigri & Gandelman, *supra* note 264, at 476-478.

<sup>278</sup> See Law No. 8.078, C.C. art. 37.

<sup>279</sup> Nigri & Gandelman, *supra* note 264, at 479.

As noted, claimants can also invoke the CBAP for protection against misleading advertisement. CONAR will entertain allegations centered on protecting an individual's image from being used in an unauthorized method. They can impose a wide variety of penalties including, warnings; recommendations to amend, alter, or correct the advertisement; and, even injunctions against further dissemination of the advertisement. However, unlike a suit under Brazil's Consumer Laws, the CBAP apply only to the advertising agency and not the advertiser itself.<sup>280</sup>

### **iii. Midler in Brazil**

Nigri and Gandelman note that Brazil's definitions of one's image include voice, name, likeness, or "other unique characteristics that distinguish the person from others."<sup>281</sup> This broad definition appears synonymous with the Midler court's broad interpretation of publicity rights under common law. Furthermore, Brazilian law does not require a demonstration of economic gain by the defendant in putting forth a colorable claim. As one court held, "any person whose image and/or name were unlawfully used for publicity reasons has suffered an invasion of privacy and a patrimonial reduction in view of someone else's profit. This unlawful use per se allows compensation."<sup>282</sup>

According to right of publicity experts, the right of image "embraces videophonogram images, television, radio, gestures, and dynamic expressions of one's personality."<sup>283</sup> Therefore, the unauthorized use of one's voice or, virtually, any body part that consumers can identify with a certain individual will lead to a redressable claim. In one case, the sister of a deceased artist objected to a film portraying the artist as an

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<sup>280</sup> *See id.*

<sup>281</sup> *Id.* at 480.

<sup>282</sup> *Id.* at 480 (*citing* Francisco Barbosa v. Caravello S.A.-Corretores de Valores e Cambio e Empresa de Propaganda e Publinews Ltda, TJG, No. 37524, Relator : Basileu Ribeiro Filho, 06.05.1975).

<sup>283</sup> *Id.* at 482.

uneducated prostitute and blackmailer. According to the facts, although the film does not mention the artist by name, viewers could easily associate the character with the artist. The court found for the sister and awarded her compensation for material and moral harm, as well as an injunction against the movie's distribution.<sup>284</sup>

In line with this precedent and statutory schemes, it is likely that Midler will succeed under Brazilian law. As discussed, the Brazilian Constitution broadly protects a person's exclusive right to their image and voice. Like the Ninth Circuit, courts in Brazil have recognized the importance of placing strict limitations on methods advertisers have to market their client's products and, therefore, have vigilantly protected against the fraudulent misappropriation of a celebrity or athlete's intrinsic value associated with their name and likeness. Although this author could not find a case directly on point with Midler, it is fair to assume that a court in Brazil would entertain an Article 5, Section X and Section XXVIII(a) suit claiming voice misappropriation through the use of an imitator. In line with Peixoto, a defendant does not have to explicitly use the claimant's "image" in order to violate the Constitutional standards. Therefore, as long as it's recognizable, simply imitating Midler's voice is no defense.

Midler could also bring a colorable claim under the consumer laws, as well as the advertising regulations. The consumer laws prohibit *any* advertisements meant to intentionally mislead the public. The court explicitly found that Ford, after Midler rejected their offer, hired one of Midler's back-up singers to replicate the crooner's voice. Consequently, the court held that the defendant intentionally desired to mislead the public. Midler would also have to demonstrate that Ford's advertisement led to actual

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<sup>284</sup> *Id.* at 484 (citing Peixoto v. Empresa Brasileira de Filmes S.A. – Embrafilme & Joaquim Vaz de Carvalho, TJRJ, No. 1186-25, Realtor: Wellington Moreira Pimentel, 07.02.1985, Unreported)

consumer confusion regarding her purported endorsement. She could verify such confusion through surveys, as well as other statistical methods. However, the one drawback in a suit under the consumer laws is that the penalties do not result in a direct remedy for the claimant. They only provide for criminal sanctions and/or a fine.

For reasons identical to those stated above, Midler could also seek redress via the CBAP in a suit under the advertising regulations. The one clear benefit to a successful claim under these regulations is that the Council can order the advertising agency to correct the advertisement or to enjoin its dissemination. The Council also has the authority to “broadcast its position on any violations committed for the failure to comply with the imposed measures.”<sup>285</sup> For Midler, who does not market her image, corrective measures may be a more suitable vindication for her image.

## **F. Canada**

Like the United States, our neighbors to the North have developed a bifurcated approach to protecting against the unauthorized use of a person’s name or likeness, in that a individual can find redress both under privacy law and a right known as “character merchandising”.<sup>286</sup> However, aside from the cosmetic similarities, the development of publicity rights in Canada differed significantly from the United States on the theoretical level. As a consequence, protection for celebrities looks, historically at least, eerily similar to those of the United Kingdom.

### **i. Historical Context**

Unlike the privacy-centric origins of publicity rights in the United States, Canada’s protection schemes arose from the desire to “provide relief against

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<sup>285</sup> Nigri & Gandelman, *supra* note 264, at 479.

<sup>286</sup> Robert G. Howell, Symposium International Rights of Publicity: Publicity Rights in the Common Law Provinces of Canada, 18 LOYOLA L.A. ENT. L.J. 487, 488 (1998).

unauthorized character merchandising through the business tort of “passing off”.<sup>287</sup>

Early in the development of this legal doctrine, Canadian legal scholars and courts realized the intrinsic economical value a celebrity’s name or image can have on the purchasing public. As Robert Howell explains, “The benefit of character merchandising is the persuasive influence on consumers that linking a celebrity with a consumer product or service may engender.”<sup>288</sup> However, the market value created by such use is, in reality, a commodity, which Howell rightly notes “belongs to the celebrity”.<sup>289</sup> As a result, Canada views the tort of passing off as a vehicle to prevent the false representation of endorsement for a particular good or service. In addition, the tort is wholly proprietary in nature, and focused on protecting the plaintiff’s goodwill.<sup>290</sup> Under Canadian jurisprudence, the tort presents two main issues: “(1) the requisite level or content of the association between the plaintiff’s and defendant’s goods or services; and (2) whether the public could be confused as to the plaintiff’s endorsement of the defendant’s goods or services.”<sup>291</sup> As Howell points out, Canadian passing off precedent, prior to the 1970s, highly resembled the United Kingdom’s historical and contemporary unwillingness to entertain celebrity claims because of their skepticism over consumer confusion due to false endorsements.<sup>292</sup> Like the UK, celebrities were required to “prove a ‘common field of activity’ between the defendant’s product and the celebrity’s persona.”<sup>293</sup> In short, fame and inherent value in one’s name or image was insufficient to bring a *prima facie* claim. However, in the early to mid-1970s courts began to recognize this inequitable, if

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<sup>287</sup> *Id.* at 490.

<sup>288</sup> *Id.* at 488.

<sup>289</sup> *Id.*

<sup>290</sup> *Id.*

<sup>291</sup> Robert G. Howell, The Common Law Appropriation of Personality Tort, 2 INTELL. PROP. J. 149, 153-154. (1986) (Can.).

<sup>292</sup> See Howell, *supra* note 286, at 490-491.

<sup>293</sup> *Id.* at 491; See Krouse v. Chrysler Canada Ltd., 40 D.L.R.3d 15 (Ont. Ct. App.) (1973 Can.).

not inexistent, relief. Consequently, the courts created a quasi-hybrid passing off tort, appropriation of personality tort that focused on the misappropriation of a celebrity's image and name rather than the highly convoluted "association" element.

## **ii. Appropriation of Personality Tort**

In Krouse v. Chrysler,<sup>294</sup> the plaintiff, a football player, sued for the unauthorized use of his image in an advertisement. Since Krouse was not in the business of selling automobiles the court held that the tort of passing off was inapplicable. However, instead of wholly dismissing Krouse's claim, the court stated, regarding the commercial misappropriation of his image, that Canadian law did indeed support a remedy for the "appropriation of commercial purposes of another's likeness, voice or personality."<sup>295</sup> The court ultimately refused to award damages because the league in which Krouse played authorized the photograph.<sup>296</sup>

Although personally unsuccessful, the court in Krouse explicitly recognized the right, and need, to provide protection against the unauthorized use of one's name and likeness. Four years after Krouse, the Ontario High Court had the opportunity to apply the appropriation of personality test. In Athans v. Canadian Adventure Camps, the plaintiff-water-skier sued for the misappropriation after the defendant used his image in advertisements.<sup>297</sup> Although the defendant did not actually use a photograph of Athans, but produced an identical line drawing from an acquired photograph, the court found that consumers would easily recognize the plaintiff from the drawing. As a result, the court

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<sup>294</sup> Krouse v. Chrysler Canada Ltd., 40 D.L.R.3d 15 (Ont. Ct. App.) (1973 Can.).

<sup>295</sup> *Id.*

<sup>296</sup> *Id.* The court also stated that the plaintiff should expect "some minor loss of privacy and even some loss of potential for commercial exploitation...as a by-product of the express or implied license to publicize the institution of the game itself."

<sup>297</sup> Athans v. Canadian Adventure Camps, 80 D.L.R.3d 583 (Ont. H.C.) (1977 Can.).

held that the defendant infringed Athans' exclusive right to market his personality. The key distinction for the court, between Athans and Krouse, was the recognizability of the photograph's subject in that the latter had his back toward the camera while the former's image was clearly depicted.<sup>298</sup> Further court decisions have reiterated the "recognizable" requirement under Canadian jurisprudence. In Joseph v. Daniels, the plaintiff claimed a violation of wrongful appropriation after the defendant exceeded the scope of consent, regarding the underlying photograph of the plaintiff's torso, and proceeded to use the photograph on posters and greeting cards.<sup>299</sup> The court held against misappropriation because the plaintiff – in that his actual facial image – was not recognizable in the photographs.

### **iii. Midler in Canada**

Midler's chances for success in Canada, like several of the other countries discussed above, depend entirely on the court's interpretation of "recognizability". The defense will have to argue that her case lies along the same line of reasoning as Athans, instead of Krouse, regardless of the fact that the defendant used an impersonator. Robert Howell identifies five elements to establishing a prima facie appropriation of personality claim, most of which mirror elements underlying a right of publicity action: "1) plaintiff must be identified in the depiction or other indicia; 2) the defendant's use of the plaintiff's persona should be more than incidental or de minimis; 3) there is no express requirement of an intent to misappropriation...; 4) there must be damage; and 5) there can not be a public interest in the publication."<sup>300</sup>

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<sup>298</sup> See Howell, *supra* note 286, at 492-493.

<sup>299</sup> Joseph v. Daniels, 4 B.C.L.R.2d 239 (B.C. Sup. Ct.) (1986 Can.).

<sup>300</sup> Howell, *supra* note 286, 494-495.

Without a doubt, Midler can establish the second, third, and fourth elements. However, the first and fifth could present challenges. As mentioned above, the court will need to take a leap in finding that the use of an imitator is no defense, as to identifiability, if the plaintiff can demonstrate that consumers could not differentiate between the sound-a-like and the true performer. If the imitation is so true, it is natural that consumer will not question whether the voice on the commercial is actually Midler, but simply assume that it is indeed her. Therefore, the use of an imitator will create the same negative impact on the commercial value of her image and voice. She will have to internalize the consequences of externalities. In addition, consumers will be duped into thinking that Midler actually endorsed such product, regardless of its potentially vile nature.

This consumer protection rationale is also very important when arguing that there does not exist any public interest in permitting advertisers from flagrantly misappropriating a person's name, image or likeness to the detriment of that party. If an advertiser asks a person's permission, celebrity or not, to use their indicia of identity and that person refuses to participate, that should be the end of the issue. Advertisers can not have the unilateral power to simply disregard that person's rejection. This is particularly true when the use of such name or image is wholly commercial in nature. Not only would it invade a private person's right to privacy and a celebrity's right to appropriate remuneration of their valuable image and name, but the advertiser is actually financially benefiting from such misappropriation, not only from the potential increase in sales of the product, but also since hiring look-a-likes and sound-a-likes probably cost far less the real thing.



The major obstacle for Midler lies in the fact that Canadian courts, to this point, have yet to consider the issue of whether the use of imitators violates the misappropriation of personality tort because the voice is still “recognizable”. The court may very likely find Midler’s claim in parallel with Krouse in that the advertisement did not explicitly depict Midler, but simply her voice. Of course, if that is the case, the question remains as to how should Midler’s persona/voice be depicted in a commercial, which simply has a song in the background, unless the ad actually showed Midler singing the song? In the end, this author simply posits that advertisers should not be given such a thinly veiled defense for the intentional and fraudulent misappropriation of another’s name or likeness.

#### **G. Foreign Protection Conclusion**

Although only a microcosm of the world-wide right of publicity protection schemes, those State schemes discussed above provide a sample of the variations that currently exist. They clearly demonstrate the divergent views of the types of protection against the unauthorized exploitation of one’s image and likeness. The fact that these countries offer such individualized remedial measures is problematic for Midler-like plaintiffs for several reasons.

First, Midler may not have the right to bring a colorable claim in all the jurisdictions where the misappropriation occurs, notwithstanding the fact that her claim arises out of identical misuse of her voice, arguably, causing identical injuries in all relevant States. We live in a world that permits the instantaneous dissemination of information on a global scale. Internet advancements, and, in particular, broadband technology provides advertisers the power to send ads, accessible with the click of a

mouse, to all corners of the world. Furthermore, the pervasiveness of satellite television gives broadcasters the ability to beam advertisements to all corners of the world.

Consequently, injuries associated with the unauthorized commercial use of one's name or image, occur not only instantaneously, but on a much greater scale than in the past.

Therefore, if one agrees that right of publicity protection is appropriate, we must concur that laws in all jurisdictions where the tort is committed must accommodate a redressable claim.

Second, many foreign jurisdictions seemingly protect solely privacy-based injuries. This stands in stark contrast to the United States where numerous jurisdictions have evolved from narrow privacy-based protection, addressing only emotional harms, to a broader scheme inclusive of economic-centered publicity rights. The main problem with statutes solely protecting emotional injuries is that US precedent have held that celebrities could not suffer emotional injuries due to the unauthorized use of their image. This exclusion exists because, like other public figures, celebrities had entered the public sphere relegating them to a lesser degree of protection.<sup>301</sup> In relation to foreign privacy-oriented laws, nothing to the contrary exists whereby a celebrity may evoke emotional injuries as the precursor to a right of publicity-esque claim. Consequently, foreign courts would deny Midler's claim for two rather circular reasons. First, she can not bring suit alleging damage to the economic value of her persona because such a claim is not redressable. Second, although Midler certainly suffered emotional and reputational harm due to Ford's misappropriation, she is barred from bringing a privacy-based suit because she is a celebrity and, therefore, her image is, in essence, part of the public domain. Her sole avenue of protection would exist if she had previously marketed her "image". Even

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<sup>301</sup> See Part II.

then, case law may require that her previous endorsements were for similar, if not identical, goods or services to that of the alleged misappropriation.

Third, States that do not protect against commercial misappropriation provide a safe haven for infringing advertisers. Countries like the United Kingdom grant advertisers arguably a green light to infringe on the intrinsic value of a celebrity's image without fear of judicial repercussions because of the difficulty in bringing a redressable claim. In short, advertisers have no incentive to refrain from intentionally misappropriating the goodwill and value associated with a particular person. The main problem with this lack of protection is that it will force a celebrity to internalize the potentially severe consequences of externalities (i.e. an advertisement depicting a fraudulent endorsement of a morally-questionable product). Aside from injury to the celebrity, consumers will also suffer, under UK law, because of the inevitable consumer confusion compounded by the court's complete reluctance to entertain the argument that consumer's expect authenticity regarding the alleged endorsement of merchandise. On the other hand, Brazil's broad-based protection - consumer law and advertising regulations - clearly demonstrate the legislatures' desire to protect consumers against misleading or fraudulent marketing.

## **Part IV: Multinational Protection Schemes**

Currently, no multilateral agreements specifically address right of publicity protection. In light of the tremendous growth in global merchandising, especially those involving U.S. celebrities, some have urged for the creation of a relevant international

scheme.<sup>302</sup> Although international harmonization has not been official proposed, this Part will analyze several multilateral agreements that either contain some level of protection or which may be best suited to include a right of publicity provision.

### **A. European Convention on Human Rights**

Article 8 of the European Convention on Human Rights (“ECHR”) contains language insinuating protection against the unauthorized use of a person’s name or image. It provides that (1) everyone has the right to respect for his family life, his home and his correspondence; (2) there shall be no interference by a public authority with the exercise of this right except such as in accordance with the law and is necessary in a democratic society...of the protection of health or morals or the rights and freedoms of others.<sup>303</sup>

The European Court on Human Rights in PG and JH v. UK interpreted Article 8 as protecting a "right to identity and personal developments and the right to establish and develop relationships with other human beings and the outside world".<sup>304</sup> In short, the Article asserts that “[e]veryone has the right to have their private and family life, home and mail respected.”<sup>305</sup> It is also important to note that Article 8 is complemented by

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<sup>302</sup> See generally Dougherty, *supra* note 1, at 421.

<sup>303</sup> See European Convention on Human Rights, sec. 1, art. 8 (1994), available at <http://www.hri.org/docs/ECHR50.html#C.Art8>.

<sup>304</sup> Jorg Fedtke, et al, Concerns and Ideas about the Developing English Law of Privacy (And How Knowledge of Foreign Law Might be of Help), 52 AM. J. COMP. L. 133, 182 (2004). In this case, the applicants complained that covert listening devices had been used to record conversations at a flat while they were detained in a police station. Thereafter, that information was obtained by the police and used in part of a police report that was, thereafter, used in evidence in their trial. Furthermore, the tape and the police report had not been disclosed to the defense at their trial and that the judge had heard evidence from the police officer concerned in the absence of the defendants.

<sup>305</sup> Logeais & Schroeder, *supra* note 173, at 513.

Article 10 addressing the freedom of expression concerns associated with too broad a right of privacy, and require that the two doctrines be balanced on an ad hoc basis.<sup>306</sup>

In the United Kingdom, the ECHR was recently incorporated into the Human Rights Act of 1998 (“HRA”).<sup>307</sup> One of the direct legislative intentions of the Act was to further common law jurisprudence regarding the right of privacy.<sup>308</sup> S. 6 of the HRA requires that courts in the UK give effect to ECHR provisions, including Article 8, to further interpret privacy right limitations.<sup>309</sup> The HRA’s incorporation of the ECHR provisions is also important because it gave claimants the right to file suit in UK court for alleged right of privacy infringements, rather than having to file suit in the European Court of Human Rights in Strasbourg, the normal venue for alleged ECHR violations.<sup>310</sup>

In a recent case, invoking the ECHR, as incorporated within the HRA, Michael Douglas and Catherine-Zeta Jones sued Hello! Magazine for publishing pictures of their wedding without consent. According to the facts, the plaintiffs had contracted exclusively with OK! Magazine for the publication of said pictures. The court held that Hello!’s actions breached Article 8, thus infringing the plaintiff’s right of privacy and confidence.<sup>311</sup> Several experts have equated the key issues in this case with a traditional

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<sup>306</sup> See European Convention on Human Rights, sec. 1, art. 8 (1994), available at <http://www.hri.org/docs/ECHR50.html#C.Art10>.

<sup>307</sup> Human Rights Bill, as approved by the House of Lords, 577 Parl. Deb., H.L. (5th ser.) 1726 (1997), introduced into the House of Commons, Feb. 6, 1998, 663 Parl. Deb., H.C. (5th ser.) 31 (1998), available in United Kingdom Parliament (visited Apr. 10, 1998), available at <http://www.parliament.the-stationery-office.co.uk/pa/cm199798/cmbills/119/1998119.htm>.

<sup>308</sup> See Fedtke, *supra* note 304, at 141.

<sup>309</sup> See *Id.*

<sup>310</sup> See Stallard, *supra* note 179, at 585.

<sup>311</sup> Douglas v. Hello! Ltd., 2 WLR 992 (CA) (2001); Douglas v. Hello! Ltd., EWHC 786 (Ch) (2003); Fedtke, *supra* note 237, at 141.

right of publicity action, although the court's decision did not explicitly use that terminology.<sup>312</sup>

While a step towards fully recognizing a right of publicity, most cases brought pursuant to Article 8 deal specifically with right of privacy issues.<sup>313</sup> This lack of jurisprudence, coupled with the court's reluctance to entertain a true right of publicity claim under either its intellectual property schemes or the common law tort of "passing off" will continue to leave plaintiffs like Midler without a redressable claim in the UK. This author did not find any European Court on Human Rights case law interpreting Article 8 under a property-based right of publicity claim.

### **B. The Berne Convention**

Most right of publicity experts agree that right of publicity protection belongs within the same pantheon as intellectual property law.<sup>314</sup> If we agree that the right of publicity should in fact exist as a neighboring right to Copyright Law, the Berne Convention for the Protection of Literary and Artistic Works ("Berne")<sup>315</sup> may provide an appropriate forum.

Currently, Berne does not provide publicity right protection. One obvious reason is that Berne was enacted in 1886, well before the unauthorized commercial use of someone's name and likeness became an international issue. However, in the one hundred-plus years since Berne's ratification, the agreement remains silent as to recognizing the right of publicity. Furthermore, the relatively recent multilateral

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<sup>312</sup> See Fedtke, *supra* note 304, at 141.

<sup>313</sup> See Lauren B. Cardonsky, Towards a Meaningful Right of Privacy in the United Kingdom, 20 B.U. INT'L L.J. 393, 410-411 (2002).

<sup>314</sup> See generally Kwall, *supra* note 44; Hamilton, *supra* note 10.

<sup>315</sup> The Berne Convention for the Protection of Literary and Artistic Works (Sept. 8, 1886) [as amended on Sept. 28, 1979], available at <http://www.wipo.int/treaties/en/ip/berne/index.html>.

agreements, enacted under the auspices of the World Intellectual Property Organization (“WIPO”), an arm of the United Nations, which administers Berne, are also devoid of relevant provisions.<sup>316</sup>

In 1996, WIPO adopted the Performances and Phonograms Treaty (“WPPT”) enunciating levels of protection not found within Berne. In particular, Article 5 protects the moral rights of performers. It states, in pertinent part: Independently of a performer’s economic rights...the performer shall, as regards to this live aural performances or performances fixed in phonograms, have the right to claim to be identified as the performer...and to object to any distortion, mutilation or other modification of his performances.<sup>317</sup> This moral-rights language is, arguably, steeped in privacy law rational, protecting against emotional and reputational harm,<sup>318</sup> and, therefore, clearly insufficient for protecting celebrities’ publicity rights. Furthermore, it is only intended to protect audio performances.

Realizing this deficiency, several groups have proposed the enactment of a treaty affording audiovisual performers both economic and moral rights.<sup>319</sup> Known as the Audiovisual Performances Treaty (“APT”) the draft Preamble states its goal as

desiring to develop and maintain the protection of rights of performers in their audiovisual performances in a manner as effective and uniform as possible, Recognizing the need to introduce new international rules in order to provide adequate solutions to the questions raised by economic, cultural and technological developments...recognizing the profound impact of the development and convergence of information and communication technologies on the production and use of audiovisual performances, recognizing the need to maintain a balance

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<sup>316</sup> PAUL GOLDSTEIN, INTERNATIONAL LEGAL MATERIALS ON INTELLECTUAL PROPERTY 174-197 (Foundation Press 2002).

<sup>317</sup> WIPO Performances and Phonograms Treaty, art. 5 (1996), available at Goldstein, *supra* note 249, at 187.

<sup>318</sup> Roberta Rosenthal Kwall, Intellectual Property Challenges in the Next Century: Preserving Personality and Reputational Interests of Constructed Personas through Moral Rights: A Blueprint for the Twenty-First Century, 2001 U. ILL. L. REV. 151, 157 (2001).

<sup>319</sup> *Id.*

between the rights of performers in their audiovisual performances and the larger public interest, particularly education, research and access to information...<sup>320</sup>

Originally drafted in 2000 at a conference in Geneva, Switzerland, the APT has yet to be ratified. The APT's draft language does not directly provide for right of publicity protection and is explicitly limited to protecting audiovisual performers in their fixed and, in a limited manner, unfixed works.<sup>321</sup> However, the Preamble, coupled with the strong desire to provide rights of celebrities, in addition to those already existing under Berne, is a clear indication that the WIPO recognizes the potential damage to an artist's intrinsic value in a "borderless" world devoid of persona-driven protection.

Although the APT would prove a significant step in the direction of creating a baseline universal right of publicity, any treaty under the auspices of the WIPO has certain drawback. Specifically, it lacks an effective enforcement mechanism. David Nimmer stated that "the Achilles' heel of all the Great Conventions is that they uniformly lack enforcement tools."<sup>322</sup> Other prominent scholars have described Berne's dispute resolution mechanism as "effectively worthless" because it did not permit private party suits.<sup>323</sup>

Since the WIPO administers Berne, a private party must petition its State Department to file suit on their behalf in the UN's International Court of Justice ("ICJ"), located in De Hague.<sup>324</sup> Theoretically a viable option, the ICJ has never heard a copyright case.<sup>325</sup> There are essentially two main reasons for this lack of judicial

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<sup>320</sup> WIPO, Basic Proposal for an Instrument on the Protection of Audiovisual Performers (Dec. 2000), at 14, available at [http://www.wipo.int/documents/en/document/iavp/pdf/iavp\\_dc3.pdf](http://www.wipo.int/documents/en/document/iavp/pdf/iavp_dc3.pdf).

<sup>321</sup> *See id.*

<sup>322</sup> David Nimmer, Essay, The End of Copyright, 48 VAND. L. REV. 1385, 1393 (1995).

<sup>323</sup> *Id.*

<sup>324</sup> *Id.*

<sup>325</sup> *Id.* (citing Emery Simon, GATT and NAFTA Provisions on Intellectual Property, 4 FORDHAM INTELL. PROP. MEDIA & ENTER. L.J. 267, 270 (1993)).



recourse. First, even if a case is brought and adjudicated, the ICJ can only enforce a judgment if the losing member-state acceded to it. The winning party would most likely have to seek enforcement through the UN Security Council via a threat of economic or trade sanctions.<sup>326</sup> Considering that a violation of copyright is relatively benign on the international sphere, a sanction is highly unlikely. Second, as Monique Cordray argues, no State would ever sue in De Hague for copyright infringement “because the sued state would interpret the action as an unfriendly act.”<sup>327</sup> Member-states have obviously decided that there are “bigger fish to fry” than copyright infringement.

In context, these experts were referring solely to the Berne Convention. However, if States are reluctant to bring copyright claims to the ICJ, notwithstanding the billions of dollars lost yearly due to piracy, we must assume that a right of publicity action will never see the light of day in the ICJ, even if a protection scheme is enacted. Furthermore, nothing in the APT’s draft would indicate the implementation of a new enforcement mechanism. Although, undoubtedly, right of publicity advocates would applaud inclusion of a publicity provision in the APT, the lack of an effective centralized dispute resolution mechanism is problematic. Claimants would have to rely on the development of internal enforcement mechanisms within the same foreign countries that have yet to “adequately and effectively” implement other WIPO treaties.<sup>328</sup>

### **C. The World Trade Organization and TRIPs**

In contrast to the WIPO, the World Trade Organization (“WTO”) does provide an effective dispute resolution mechanism governing all its treaties, including the

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<sup>326</sup> *Id* at 1393.

<sup>327</sup> Monique L. Cordray, *GATT v. WIPO*, 76 J. PATENT AND TRADEMARK OFF. SOC’Y 121, 131 (1994).

<sup>328</sup> See Trade Act of 1974, 19 U.S.C. 2242, § 182 (“Special 301”), *available at* <http://uscode.house.gov/download/pls/19C12.txt>.

Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPs”).<sup>329</sup>

Enacted in 1994, TRIPs provides standards concerning the availability, scope, and use of all three main intellectual property rights – copyrights, trademarks, and patents.

Furthermore, TRIPs Article 9 incorporates Articles 1 through 21 of Berne, minus Article 6-bis protecting moral rights.<sup>330</sup>

Although TRIPs does not explicitly protect the right of publicity, some level of protection may exist under Section 2, relating to Trademarks. In particular, Article 15(1) defines protectable subject matter as: Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including *personal names*, letters, numerals...shall be eligible for registration as trademarks.<sup>331</sup>

(*emphasis added*) Thereafter, Article 16(1), enumerating conferred rights, states:

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.<sup>332</sup>

Taken in combination, Articles 15 and 16 will provide some level of protection for celebrities. First, it explicitly provides for the registration of personal names. Second, Article 16’s exclusive rights prohibit the unauthorized use of a registered name. Third, if a defendant appropriates an exact use of the mark, the claimant is not required to

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<sup>329</sup> See Alain Lapter, The WTO’s Dispute Resolution Mechanism: Does the United States Take it Seriously? A TRIPs Analysis, 4 CHI-KENT J. INTELL. PROP. 217 (2005); The World Trade Organization website, Uruguay Round Agreements: TRIPs, *available at* [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_02\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-trips_02_e.htm).

<sup>330</sup> The World Trade Organization website, Uruguay Round Agreements: TRIPs Relation to the Berne Convention, art. 9, *available at* [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_04\\_e.htm#1](http://www.wto.org/english/docs_e/legal_e/27-trips_04_e.htm#1).

<sup>331</sup> TRIPs, sec. 2, art. 15(1), *available at* [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm).

<sup>332</sup> TRIPs, sec. 2, art. 16, *available at* [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm).

demonstrate consumer confusion. The ensuing confusion is presumed. The Article's language also implies that if the claimant can demonstrate an appropriate level of consumer confusion, they can prevail even if the defendant did not duplicate the trademark, in toto. For example, assume Michael Jordan owns the trademark to his name. If an advertiser uses the "MICHAEL JORDAN" mark without consent, he is in violation of Article 16, regardless of whether consumer confusion exists. Furthermore, even if the advertiser uses the mark "M.J." to sell basketball shoes, he may remain liable if Michael Jordan can prove that the use of those initials to sell basketball apparel is misleading and results in confusion as to his implied sponsorship of the product. Consequently, TRIPs drafters recognized, though narrowly, the need for a certain level of publicity protection because the unabated use of a celebrity's name has the potential to cause severe consumer confusion, which trademark law, at its root, attempts to prevent.

Though Article 15 and 16 protections are not broad enough to encapsulate right of publicity, in toto, it does provide evidence that international intellectual property negotiators recognize the existence of a problem. Protection under TRIPs is also important because of the dispute resolution mechanism non-existent under Berne. Unlike the WIPO, which has never presided over a copyright infringement claim, the WTO enacted a revolutionary dispute resolution mechanism capable of providing effective and forceful jurisprudence. Consequently, the WTO has presided over hundreds of cases invoking agreements under their auspices, including several dozen claims alleging violation of TRIPs.<sup>333</sup>

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<sup>333</sup> See generally Lapter, *supra* note 329, at Part II.

#### **D. Multilateral Agreements Conclusion**

Currently, no multilateral agreements exist which explicitly protect the right of publicity to any certain degree. Several organizations, ECHR and WIPO, have either a limited privacy-based protection or have only proposed a treaty that, in theory, would accommodate some publicity rights. Meanwhile, trademark protection under TRIPs will protect one dimension of a celebrity's persona – his name. The WTO's additional benefit is the creation of a truly effective dispute resolution mechanism that for the first time provides international jurisprudence protecting a celebrity's name, registered as a trademark, against unauthorized commercial use.

Perhaps the greatest catalyst for a true international right of publicity regime would require the intervention of the United States. As noted, U.S. celebrities are marketed on a global scale and misappropriation of their likeness results in losses in the millions of dollars. Akin to the United States' desire to forge a stronger international copyright regime, in order to stifle the billions of dollars lost to global IP piracy, right of publicity losses should also serve as an impetus to establish a strong regime. However, it remains difficult to imagine that the United States will promote a harmonized right of publicity scheme in the near future. The obvious obstacle is the fact that the federal government remains unwilling to enact even a harmonized right of publicity within its own borders. They have systematically rejected the notion, thereby leaving protection to the states. Consequently, protection may only come through the efforts of a foreign nation's proposal.

## **Part V: Copyright v. Trademark Law – Where does Right of Publicity Fit?????**

This paper has attempted to establish the current state of right of publicity protection in the United States, in several countries on various continents, and on the international level. This survey has unequivocally demonstrated that a harmonized universal right of publicity simply does not currently exist, both in its theoretical perceptions and in either statutory schemes or jurisprudence. It has also exposed the extreme state of flux and uncertainty in which potential plaintiffs find themselves, particularly on the international level. However, this paper has also attempted to highlight the need for such protection because of the harm it can, and has, caused to the right-holder, and, perhaps more importantly, the consumer.

### **A. Right of Publicity – A Copyright...A Trademark...Not Intellectual At All???**

In order to promulgate the most efficient and effective solution to producing a harmonized international right of publicity statutory scheme, as well as proper remedial measures, one needs to consider what avenue of intellectual property this right falls into, in any. As discussed below, both the Copyright and Trademark statutory schemes present advantages and disadvantages to the right of publicity, and neither could fully incorporate an effective protection scheme without substantial and detailed amendments.

#### **i. Copyright Law**

The Copyright Act of 1976 provides for protection of original works of authorship that are both fixed in a tangible medium of expression and that “come within the subject matter of copyright as specified by Sections 102 and 103.”<sup>334</sup> Section 102 puts forth an illustrative, but **not** exhaustive, list of subject matter that includes: literary works; musical

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<sup>334</sup> 17 U.S.C. § 301(a) (1976).

works; dramatic works; pictorial, graphic, and sculptural works; audiovisual works; and, sound recordings.<sup>335</sup> As such, the indicia of identity that has become synonymous with right of publicity protection – name, voice, persona – are not included within this list. Therefore, those proprietary aspects would have to be legislatively incorporated into the Act or through jurisprudence.

As a preeminent scholar on the right of publicity, Professor Kwall argued that “a constructed persona should be considered a “writing” within the meaning of the Constitution.”<sup>336</sup> Citing the legislative history of the 1976 Act, Prof. Kwall contends that the recognition of a persona as a “writing” is a logical and natural expansion beyond its meaning to the original framers of the Constitution.<sup>337</sup> As Kwall points out, the Supreme Court in Goldstein v. California<sup>338</sup> stated that the “history of federal copyright statutes indicates that the congressional determination to consider specific classes of writings is dependent, not only on the character of the writing, but also on the commercial importance of the product to the national economy.”<sup>339</sup> In essence, the Court held that Congress has broad discretion when deciding what is to be considered a “writing”.<sup>340</sup> Taking this broad grant of authority, coupled with the “Americans love to model celebrities’ buying patterns,”<sup>341</sup> Kwall argues that the consumer culture in which we live justifies the “support for recognizing constructed personas as writings for the purpose of copyright law.”<sup>342</sup>

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<sup>335</sup> 17 U.S.C. § 102 (1976).

<sup>336</sup> Kwall, *supra* note 318, at 160.

<sup>337</sup> *Id.* at 160-161.

<sup>338</sup> 412 U.S. 546 (1973).

<sup>339</sup> Kwall, *supra* note 318, at 161 (*quoting* Goldstein v. California, 412 U.S. 546, at 562 (1973)).

<sup>340</sup> Kwall, *supra* note 318, at 161.

<sup>341</sup> *Id.* at 162.

<sup>342</sup> *Id.*

However, Prof. Kwall's insightful position would undoubtedly present significant pragmatic issues. First, a persona is quite different than a computer program, or other "writing", not found explicitly under Section 102 or originally envisioned by the Framers. Unlike a true "writing", which any party can perceive one way or another because it is "fixed on a tangible medium of expression", as required under the 1976 Act, a "persona" is wholly amorphous and ambiguous. How would a celebrity quantify their persona in court, or much less register it with the copyright office? A "writing" is also something that does not change. Once it is put down in writing, it exists as is. Even if the author amends the original or produces derivative works, the original will most likely always exist and will always be perceptible, as such. However, personas are naturally bound to change over time. Therefore, if copyright law would recognize a persona as a "writing", thereby granting it the statutory length of protection, and, thereafter the persona no longer exists, would such protection also cease? A "writing", as envisioned by the Framers, as well as Congress, involves a tangible writing that does not mutate or cease to exist, regardless of the amount of revisions, adaptations or derivatives. The underlying work will always remain. The same can not be said for a celebrity's persona, which, arguably, evolves and vacillates throughout their careers.

Prof. Kwall's argument would also require a complete departure from numerous federal cases unequivocally holding that "[A] person's person does not fall within the subject matter of copyright – it does not consist of 'a 'writing' of an 'author' within the meaning of the Copyright Clause of the Constitution."<sup>343</sup> As for Midler, the fact that her

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<sup>343</sup> Brown v. Ames, 201 F.3d 654, at 658 (5th Cir. 2000); 1 Melville B Nimmer & David Nimmer, NIMMER ON COPYRIGHT §1.01[B][1][C]; Jarvis v. A&M Records, 827 F. Supp. 282, 297 (D.N.J. 1993); Bi-Rite Enterprises, Inc. v. Button Master, 555 F. Supp. 1188, 1202 (S.D.N.Y. 1983); Apigram Publishing Co. v. Factors, Etc., Inc., 1980 U.S. Dist. LEXIS 9738, 1980 WL 2047 (N.D. Ohio July 30, 1980).

“vocal style” was not considered “fixed” by the Ninth Circuit, and, therefore, did not come under the purview of the 1976 Act, was critical to her right of publicity claim because if it had, her publicity claim would have been preempted by Section 301 of the Copyright Act. Underlining the inherent evolution of a persona, the court in *Midler* further reasoned that “[a] voice is as distinctive and personal as a face.”<sup>344</sup> Inherently, a voice, as well as a face continually goes through changes. These mutations further undercut the contention that a persona can be included as a “writing” under the 1976 Act because of the impossibility of tangibly identifying the indicia, unless it is captured in a photograph or recording – both explicitly protected under the 1976 Act.

Protection under copyright laws does present several distinct advantages. First, copyright law does not discriminate between the famous and non-famous. Any person can gain protection under the 1976 Act so long as they produce an original work of authorship in a tangible medium of expression. Of course, with such broad protection comes the potential for problems. First, if we were to protect someone’s “persona” under copyright law, we would, in essence, be granting everyone an exclusive right over their indicia of identity for life plus seventy years. It is easy to imagine the chaos this would cause in litigation. How can one person justify or quantify that they should be the sole holders of a persona? How can someone prove that in court?

A further complication would reside in the protection of names. In the United States alone there are over 2500 people named “Michael Lewis”.<sup>345</sup> If copyright were to grant an exclusive use to someone’s persona, regardless of fame or further proof of

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<sup>344</sup> *Midler*, 849 F.2d 460, at 463.

<sup>345</sup> Nationwide Yahoo people search for the name Michael Lewis, available at <http://phone.people.yahoo.com/py/psPhoneSearch.py?srch=bas&D=1&FirstName=michael&LastName=lewis&City=&State=&Phone=&Search=Phone+and+Address+Search>



source identification, which of these people deserve to hold and enforce such protection? Even if famousness were a requirement under copyright law, an issue would exist. Should the Michael Lewis who plays for the Philadelphia Eagles become the sole right-holder or the Michael Lewis who plays for the New Orleans Saints? Or should protection be given to the Michael Lewis who works as a trademark examining attorney at the United States Patent and Trademark Office? As one can easily imagine, extending existing copyright laws to include all indicia of identity, currently protected through jurisprudence and state laws would create a tidal wave of litigation. Therefore, even though the 1976 Act is superior in that it protects ALL authors, instead of solely the famous, such all-encompassing protection will create severe problems.

Another advantage of the copyright system is that protection is limited to life of the right-holder plus seventy years. Although, this author is certain that the trustees of Elvis Presley's estate would vehemently disagree, the right to protect one's name and image should terminate at some point after the holder's death. A person's name, likeness, persona, singing style, or other indicia of identity simply should not be protected in perpetuity, if such underlying protection is based on proprietary protection and economic exploitation of such characteristic. However, if the justification for the right of publicity is predicated on consumer protection, one can make a stronger case for perpetual rights. Yet it is difficult to imagine a scenario where consumers would become duped by a false endorsement from a celebrity who died a century ago. All intellectual property expires at some point of another. Even trademarks, which fundamentally protect consumers from fraud, are perceptible to abandonment and cancellation based on non-

use. Publicity rights should be no different. Therefore, the strict time limitations under the Copyright Act may provide the proper framework.

## **ii. Trademark Law**

Unlike Copyright law that has only been mentioned in passing as a possible avenue of protection for publicity rights, trademark law has been the focus of several proposals for federal protection. Although many argue that right of publicity protection is a natural fit as a subset of trademark law, the current federal trademark protection scheme would create significant issues including the length of protection, as well as registration and use of the mark requirements.

Several years ago, the American Bar Association (“ABA”) and the International Trademark Association (“INTA”) advanced the most ambitious undertaking regarding the federalization of publicity rights. Although both were ultimately unsuccessful, the proposals would have called for an expansion of the Lanham Act to include “persona” rights. The INTA’s proposal would treat publicity rights, defined as “persona” rights in their proposed amendment, as trademarks.<sup>346</sup>

The INTA suggested an amendment to Section 45 of the Lanham Act that would define “persona” as:

"persona" means the following or an imitation thereof: the legal name of any natural person or any other name by which a natural person is known to any material segment of the general public; signature; voice; image; distinctive characteristics or appurtenances by which a natural person is known to any material segment of the general public; or a character portrayed by the natural person on stage, in film or television or in live performances or other entertainment media, provided that the character has been created by the natural person and has become so associated with the natural person as to be indistinguishable from the natural person as to be indistinguishable from the natural person’s public image.

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<sup>346</sup> O. Yale Lewis Jr., *Personality, Persona, and Publicity Rights* (1997), available at [http://www.hllaw.com/a\\_personality.html](http://www.hllaw.com/a_personality.html).

(1) The term "image" includes, but is not limited to, a picture, portrait, likeness, photograph or photographic reproduction, still or moving, or any videotape or live television transmission or audio/visual representation or any analog or digital representation or transmission or any other method of creating or reproducing a likeness, now known or hereafter created, such that the natural person is readily identifiable.

(2) A natural person shall be deemed to be "readily identifiable" from an image when one who views the image with the naked eye can reasonably determine that it is such natural person depicted in the image.<sup>347</sup>

Registration and exploitation of persona rights would be required. In addition, and unlike copyright protection, persona protection under the INTA proposal would be renewable at ten-year intervals, indefinitely, and would be freely transferable and descendible.

Although a profound proposal and one that would finally bring publicity rights in a federal protection scheme and, thus, create harmonization from among the menagerie of state laws, several key problems would persist under this legislation. First, depending on how the courts define and interpret the exploitation requirement, artists like Tom Waits may find themselves shut out from federal protection simply because they refuse to extend the commercialization of their persona. If courts interpret the wording liberally, Waits' musical recordings and sales thereof would provide sufficient exploitation of his voice to garner protection against any form of unauthorized use, regardless of product. However, a narrow reading of the statute's language may provide him protection only for certain types of exploitation. In essence, if an actor uses his image to endorse clothing, he would only get protection from unauthorized appropriation in that specific field of goods. If so, this would become a distinct disadvantage to artists like Waits who universally rejects endorsement proposals. The system would, in essence, require artists to exploit their persona, regardless of personal choice.

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<sup>347</sup> *Id.*

Second, the system may become problematic in its registration requirements. Currently, a trademark applicant is required to select a class of goods or services for which they intend to use the trademark. There currently exist forty-five (45) international classes and the applicant is required to submit separate filing fees for each class for which they seek protection.<sup>348</sup> Would artists be required to select a certain class of goods and/or services when they register for trademark protection? If the proposed amendment would require “persona” applicant’s to select classes of goods and services for which they seek protection, does that permit free-riders to fraudulently use that applicant’s persona on goods or services for which they did not apply? The problem arises in that artists who wish to avoid potential consumer confusion would, in actuality, have to register for every class, a costly proposition.<sup>349</sup> Intrinsically, there exists a major difference between a normal trademark, with literal and/or design elements, and a trademark consisting of someone’s persona. Under contemporary trademark law, two different owners can register the identical mark, so long as the mark is being used on sufficiently different goods and/or services.<sup>350</sup> These marks can co-exist because consumers would not in all likelihood confuse the source of the goods. Consumers would not believe that Delta Airlines also produces piping, and vice-versa. However, the same can not be said for a celebrity’s persona. Whether a third party uses Bette Midler’s voice or image to sell cars, t-shirts, financial services or chemicals, consumers will recognize the voice as emanating

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<sup>348</sup> Basic Facts about Trademarks, US Patent and Trademark Office, *available at* <http://www.uspto.gov/web/offices/tac/doc/basic/>.

<sup>349</sup> US PTO Fee Schedule, US Patent and Trademark Office, *available at* <http://www.uspto.gov/web/offices/ac/qs/ope/fee2006apr05.htm#tm>.

<sup>350</sup> The mark DELTA, by itself, is registered 83 times on the Principal Register at the US Patent and Trademark Office, many times for different goods and services and by different owners. See Registration Nos. 3032456 for flow meters, 2836460 for management of domain names, 2790443 for hand tools, 2824774 for medical gloves, 2519490 for laboratory equipment, 1454459 for snow skies, among many others.

from only one source and will likely, yet falsely, believe that Midler endorses that product.

Third, a federal trademark would, theoretically, grant the right-holder perpetual protection over the marks. Although this author assumes that most celebrities would enthusiastically endorse such rights, with time it would also begin to defeat the underlying purpose of trademark law as a consumer protection scheme. At its core, trademark law grants applicants the unilateral right to use a source identifier on products and services in order to protect consumers by ensuring them that products and services come from the source indicated. Otherwise, what is to stop 20 other producers of soda to stick the mark COKE on their goods? Perpetual protection is granted because consumers today or in 100 years from now want the assurance that the COKE they buy on store shelves is actually manufactured by the Coca-Cola Corporation. Of course, if this corporation ceases to exist, the mark is considered cancelled because of abandonment and, thereafter, can be claimed on a first-come-first-serve basis. However, the situation is different for celebrities in the sense that consumers are not apt to assume that the celebrity whose name or image appears on the product actually manufactures the good. Consumers are likely to believe that the celebrity is simply endorsing the good or service. Based on that assumption, perpetual protection is unnecessary some period of time following the celebrity's death. If a perfume called "Essence by Marilyn Monroe" was to come on the market today, would consumers actually view the mark as a source identifier in that Marilyn Monroe actually endorsed the product? It is hard to fathom that the typical consumer would make this determination. Furthermore, even if the product is manufactured by the celebrity or with the celebrity's input, this author argues that that

person's death is analogous to Coca-Cola going out of business and having their mark cancel through abandonment.

This author does posit that some period of protection must exist for celebrity persona marks beyond that individual's death because a celebrity's established goodwill and reputation does not simply evaporate at time of death. The goodwill certainly continues to exist, especially if products bearing that person's name remain in the marketplace. This suggestion would also strike a balance between the two main justifications for right of publicity protection: economic protection as a property right and as a consumer protection device. Judge Howell, in Allen v. National Video, stated that the Act extended to the protection of a celebrity's "commercial investment in the drawing power of his or her name and face in endorsing products and in marketing a career...The underlying purposes of the Lanham Act...appear to be implicated in cases of misrepresentations regarding the endorsement of goods and services."<sup>351</sup> However, over time this persona would naturally lose value as a source identifier to the point that it becomes nothing more than a cosmetic addition to any mark. Furthermore, any protection beyond the point of source identification would undermine the purpose of the Lanham Act, morphing protection justifications from consumer-centric to one based on a proprietary right in the economic value of a persona.

For example, in the 1950s the mark CHARLIE CHAPLIN for walking canes would most likely create an implication that Charlie Chaplin had some connection with the goods, especially since his canes became intricately linked to his persona. However, use of the same mark in 2005 would create a completely different commercial impression. One where a consumer would not assume that Chaplin endorsed the canes or

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<sup>351</sup> Allen v. National Video, 610 F. Supp. 612, at 625-626 (S.D.N.Y. 1985).

helped in their manufacture, but perhaps that the canes is styled after those that the actor used in his films. This example demonstrates that the significance of a celebrity's name as a source identifier changes and weakens. Therefore, perpetual protection for a mark that no longer functions as a source indicator is counter to the underlying objective of trademark law. Based on this argument, this author would recommend that any right of publicity protection instilled within the Lanham Act be protected for the duration of the mark-holder's life plus 50 years.

## **Part VI. Solution**

This section tries to develop a harmonized statutory scheme that would incorporate the over-arching aspects of contemporary right of publicity laws, while also trying to infuse international ideology and doctrine. It is inconceivable to produce language that would wholly and seamlessly integrate all viewpoints, statutory language and jurisprudence, regardless of validity. However, the author believes that symmetrical statutory language could accommodate the majority of existing laws, without drastically altering or eliminating current protections and expectations.

### **A. Statutory Solution**

As discussed above, both copyright law and trademark law have advantages and disadvantages when it comes to publicity protection. Perhaps the main difference between copyright and trademark is the underlying justifications for protection; economic expectations versus consumer protection and unfair competition, respectively. However, in light of international jurisprudence and statutes relating to the right of publicity, such protection must be perceived as protecting consumers against deceptive use of another's

source identifier, and, therefore belongs under the trademark umbrella. It should also be noted that although the stated purpose of trademark law is consumer-centric, individuals and companies also obtain marks for their economic and proprietary value, coupled with the perpetual monopolistic protection granted under the Lanham Act. Accordingly, this section will promulgate a protection scheme through a quasi-piecemeal approach that will incorporate both statutory and court-created laws.

The new integrated international statute, incorporated within the TRIPs Agreement, as discussed below, is proposed as follows:

## **SECTION 9: RIGHT OF PUBLICITY**

### **Article 1**

#### **Protectable Subject Matter**

1. Any Persona or Image of the Registrant capable of registration.
  - a. "Persona" means the following or an imitation thereof: the legal name of any natural person or any other name by which a natural person is known to any material segment of the general public; signature; voice; image; distinctive characteristics or appurtenances by which a natural person is known to any material segment of the general public; or a character portrayed by the natural person on stage, in film or television or in live performances or other entertainment media, provided that the character has been created by the natural person and has become so associated with the natural person as to be indistinguishable from the natural person as to be indistinguishable from the natural person's public image.
  - b. "Image" includes, but is not limited to, a picture, portrait, likeness, photograph or photographic reproduction, still or moving, or any videotape or live television transmission or audio/visual representation or any analog or digital representation or transmission or any other method of creating or reproducing a likeness, now known or hereafter created, such that the natural person is readily identifiable.<sup>352</sup>
2. Members may make registrability of a Persona or Image dependent on actual use of the Persona or Image. However, actual use of a Persona or Image shall not be a condition for filing an application for registration. An application shall not be

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<sup>352</sup> Lewis, *supra* note 346.



- refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of the application.<sup>353</sup>
3. Members may make registrability of a Persona or Image dependent on evidence of acquired distinctiveness acquired through use.
  4. The nature of the goods or services to which registration in a Persona or Image is to be applied shall in no case form an obstacle to registration of the Persona or Image unless the nature of the goods or services, as enumerated in the application, would violate criminal or civil statutes of the Member issuing the registration.<sup>354</sup>
    - a. Individuals need not identify specific goods or services for which they are seeking protection. Individuals will receive protection for all goods and services for the duration of the protection period.
  5. Members shall publish each application for a Persona or Image before it is registered and shall afford a reasonable opportunity for petitions to oppose to either cancel or narrow the registration. In addition, Members may afford an opportunity for the Registration of a Persona or Image to be opposed.<sup>355</sup>

### Rights Conferred

1. The Registrant shall have the exclusive right to prevent third parties not having the owner's consent from —
  - a. using in commerce any reproduction, counterfeit, copy, or colorable imitation of a registrant's Persona or Image in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
  - b. reproducing, counterfeiting, copying, or colorably imitating a Registrant's Persona or Image and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive<sup>356</sup>
2. Rights conferred are dependent on the valid and live registration of a Persona or Image within a Member's registry.

### Term of Protection

1. "Initial Period of Protection" - Rights in Persona and Image shall last for the lifetime of the Registrant plus a period of fifty (50) years after the death of the Registrant.<sup>357</sup>

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<sup>353</sup> See TRIPs, sec. 2, art. 15(3), available at [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm).

<sup>354</sup> See TRIPs, sec. 2, art. 15(4), available at [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm).

<sup>355</sup> See TRIPs, sec. 2, art. 15(5), available at [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm).

<sup>356</sup> See Lanham Act, 15 U.S.C. 1114 (2006).

<sup>357</sup> See generally, Tenn. Code Ann. 47-25-1104(a).

2. Following the Initial Period of Protection, rights are subject to abandonment and cancellation in goods or services on which the Persona or Image have not been commercially exploited for a period of two consecutive years.<sup>358</sup>
3. The right-holder will retain protection on goods or services on which the Persona or Image is in use, so long as that holder does not fail to commercially exploit that such Persona or Image, in any acceptable form, on such goods and services for a period of two consecutive years. Rights to use the Persona or Image on goods or services for which it was never commercially exploited during Initial Period of Protection or not exploited on goods or services for two consecutive years are subject to a cancellation immediately succeeding the termination of the fifty-year period following the original Registrant's death.
4. Circumstances arising independently from the will of the right-holder in Persona or Image that constitute a bona fide obstacle to the use of the Persona or Image shall be recognized as valid reasons for non-use. Such reasons will not serve as a bar to cancellation for goods or services on which the Persona or Image had not been commercially exploited during the Initial Period of Protection.<sup>359</sup>

### Transferability and Descendability

1. Rights in Persona and Image vest in the right-holder regardless of whether such rights were commercially exploited during that individual's lifetime by either that individual or a licensee or assignee. Rights in Persona or Image shall be deemed exclusive to the individual, or licensee or assignee of such rights, for the full duration of such rights as protected under this statute.
2. The individual rights provided for in this statute are considered property rights and are freely assignable and licensable.<sup>360</sup>
3. Rights in Persona and Image constitute rights in property and are freely and wholly or severally transferable by any means or testamentary instrument during the right-holder's lifetime or by the successors-in-interest for the duration of the period of protection under this statute.
4. Under no circumstance will the period of protection be extended beyond the statutory provision, regardless of testamentary or contractual agreements.

### Exceptions

1. Members may provide limited exceptions to the rights conferred by a registration for a Persona or Image, such as fair use and newsworthiness, provided that such exceptions take account of the legitimate interests, economical and proprietary, of the right-holder and third parties. Exceptions must also take into account the public's interest in avoiding consumer confusion as it relates to the endorsement of goods and/or services.

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<sup>358</sup> *Id.*

<sup>359</sup> See TRIPs, sec. 2, art. 19(1), available at [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm).

<sup>360</sup> See Goodman, *supra* note 116, at 267 (citing Tenn. Code Ann. 47-25-1103(b)).

2. Members shall confine limitations and exceptions to exclusive rights to certain special cases that do not conflict with a normal exploitation of the Persona or Image and do not unreasonably prejudice the legitimate interests of the right-holder.<sup>361</sup>
3. In no way will exceptions hinder a third-party's right to use a Persona or Image when used in association with: criticism, comment, teaching, News Reporting, scholarship or research.
  - a. "News reporting" means a medium that publishes, broadcasts, or disseminates information in the normal course of business including, but not limited to the Internet, newspapers, magazines, radio and television.<sup>362</sup>

## **B. Remedial Solution**

In this author's opinion, any international agreement requires a definitive and effective dispute resolution mechanism with a resolute enforcement mechanism. Otherwise, the words of the page are simply nothing more than window dressing, without any real requirements to adhere to those provisions or incorporate them into national law. Consequently, a proper and complete harmonized right of publicity agreement will require a dispute resolution mechanism that would substantially protect the right holder.

To that end, this author would propose that the World Trade Organization ("WTO"), and in particular the Agreement on Trade-Related Aspects in Intellectual Property, may be the most appropriate authority to promulgate, administer and enforce any harmonized international agreement on right of publicity. The WTO is clearly advantageous, unlike any agreement under the auspices of the United Nations, because of its dispute resolution provisions that create an effective and enforceable remedial solution.<sup>363</sup>

However, the requirements for obtaining judicial review under the WTO can create certain roadblocks for potential plaintiffs. Particularly, the WTO does not permit

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<sup>361</sup> See TRIPs, sec. 1, art. 13, available at [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm).

<sup>362</sup> See Goodman, *supra* note 116, at 277 (citing Ind. Code 32-13-1-4 (now 32-36-1-4)).

<sup>363</sup> See generally Lapter, *supra* note 329.

individuals to bring claims before the dispute resolution panel. Only Member-States are permitted to bring claims, which would require an individual right-holder to petition its country's State Department, or similar government agency, to take the case before the WTO.<sup>364</sup> It is difficult, if not impossible, to imagine a situation in which a country would entertain the idea of bringing a claim in the WTO against another Member-State on behalf of just one individual. There are simply more important issues than one person's grievance. Of course, two other viable avenues of recourse exist. First, any right of publicity agreement would require Member-States to implement such rights into its national law. Therefore, the right-holder has the option of bringing a claim in that particular State.

Second, a State may be more willing to entertain and bring a claim before the WTO if multiple right-holders felt aggrieved, and advocated for a joint claim. This scenario recently occurred between the European Union and the United States in regards to the Fairness in Music Licensing Act ("FMLA").<sup>365</sup> There, although a claim that the United States was obviating from its copyright requirements under TRIPs was originally brought to light by a group of Irish musicians, the EU decided to bring the case before the WTO after a group of musicians brought identical petitions.<sup>366</sup> Therefore, if the Motion Picture Association of America brings forth a petition on behalf of numerous celebrities and claims that China's laws permit unabated persona infringements that result in substantial economic losses and endangers the individuals' reputation and commercial value of their name and image, it is conceivable that the United States would entertain the action.

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<sup>364</sup> *Id.* at 227.

<sup>365</sup> *See generally*, Lapter, *supra* note 329, 238-250.

<sup>366</sup> *Id.*

It is certainly understandable that an international body, administering intellectual property rights, would not permit individual standing before its dispute resolution mechanism. Therefore, even though individual actions would require extensive travel and local counsel costs, in that the claim would have to be brought before national courts, it is certainly more sensible than the alternative. In short, regardless of the method through which persona rights are harmonized and guaranteed, the international body administering the agreement must also incorporate an effective mechanism to resolve disputes. By such a measure, it would create overwhelming disincentives for countries to simply disregard the provisions because of either national interests or lack of enforcement.

## **Part VII. Conclusion**

The comparison of multiple foreign legal models is “needed now more than ever because of the expansion of international transactions; the globalization of legal culture; and the movements for unification, federation, and law reform around the world.”<sup>367</sup> This is no different than with the right of publicity since the global “merchandising” of celebrities, and, in particular, those residing in the United States have grown significantly. Consequently, using Midler as a backdrop, this paper’s overall aim was to survey the existence, if any, of right of publicity protection schemes throughout the world. In addition, this paper attempted to put forth a viable regulatory scheme that would, not only represent the differing views on publicity protection, but also finally

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<sup>367</sup> Dougherty, *supra* note 1, at 421.

recognize the problem of divergent regulatory schemes and, therefore, create an acceptable, and much needed, solution.

Satellite television and broadband Internet have provided mediums that give advertisers the ability to simultaneously disseminate advertisements on a global scale. This technology, coupled with the intrinsic value of a celebrity's persona, makes for a lethal combination that without effective protection measures will systematically strip him of any real marketable value to his name or likeness. Consequently, a comprehensive and harmonized international right of publicity is not only necessary in the digital age, but the only effective and equitable means of protection. Without such legislation, advertisers will have free reign to alienate an individual from his most precious property...himself.